(33,868)

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1928

No. 559

EDWARD BECHER, PETITIONER,

vs.

CONTOURE LABORATORIES, INC., AND HERBERT OPPENHEIMER

ON WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SECOND CIRCUIT

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IN UNITED STATES DISTRICT COURT, SOUTHERN DISTRICT OF NEW YORK

Equity. No. 46-7

EDWARD BECHER, Plaintiff,

vs.

CONTOURE LABORATORIES, INC., and HERBERT OPPENHEIMER, Defendants

BILL OF COMPLAINT

To the Honorable, the Judges of the United States District Court for the Southern District of New York:

The plaintiff, for his Bill of Complaint, on information and belief, alleges:

1. This is a suit in equity for infringement and threatened infringement of Letters Patent of the United States No. 1,634,316 granted to the plaintiff, Edward Becher, July 5, 1927, for improvements in massaging heating roller. It arises under the patent laws of the United States and is brought in equity because an injunction is necessary for the protection of plaintiff's rights, which will be irreparably injured unless the infringing acts and threatened infringing acts of the defendants are enjoined, and because the plaintiff has no adequate remedy at law. Further and incidental relief is also asked because of certain frauds perpetrated [fol. 2] by the defendants upon the plaintiff through the instrumentality of an action pending in the Supreme Court of the State of New York for Kings County, entitled Contoure Laboratories, Inc., and Herbert Oppenheimer, plaintiffs, against Edward Becher, defendant, File No. 23237/27.

2. The plaintiff, Edward Becher, is a citizen of the United States and also a citizen of the State of New York, residing in the City of New York, County of Queens and State of New York.

3. Plaintiff avers, upon information and belief, that the defendant, Contoure Laboratories, Inc., is a corporation organized and existing under the laws of the State of New York, is a citizen of said State and has a regular and established place of business in the City, County, State and Southern District of New York and is a resident and inhabitant of said State, and that the other defendant, Herbert Oppenheimer, is also a citizen of the United States and of the State of New York, residing in the City, County, State and Southern District of New York.

4. Plaintiff is informed and believes and therefore avers that prior to March 27, 1926, the filing date of the application for United States Letters Patent above referred to, Edward Becher, then and now a citizen of the United States, became and was the true, original, first and sole inventor of the improvement described and claimed in said Letters Patent which improvement was both new and useful; that [fol. 3] such improvement was not known or used by others in this country before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country before the invention or discovery thereof by the said Becher, or more than two years prior to his said application for Letters Patent, and no application for foreign Letters Patent therefor had been filed more than twelve months prior to the filing of his application for Letters Patent in this country, and that the improvement had not been in public use or on sale in the United States for more than two years prior to the said Becher's application for patent therefor, and that the invention had not been abandoned.

5. That on the 27th day of March, 1926, the said Edward Becher made application to the Commissioner of Patents of the United States in accordance with the then existing statutes of the United States, and having complied in all respects with the conditions and requirements of said statutes, on the 5th day of July, 1927, Letters Patent of the United States numbered 1,634,316 were issued to said Becher, wherein there was secured to him and his legal representatives and assigns, for the term of seventeen years from the 5th of July, 1927, the full and exclusive right of making, using and vending the said invention throughout

the United States and territories thereof, as by said Letters Patent or duly authenticated copy thereof, ready in Court to be produced, will more fully and at large appear. [fol. 4] 6. That the plaintiff, Edward Becher, has for a time manufactured massaging heating rollers, as set forth in said Letters Patent No. 1,634,316 and took one of such instruments to the defendant, Herbert Oppenheimer, on or about the 23rd day of March, 1926, and disclosed the said instrument to said Oppenheimer and at the same time disclosed that an application for patent thereon was pending and filed by said Becher. Said Becher then solicited an order for such rollers from said Oppenheimer and was successful in getting a small order for samples, which order was duly filled, and thereafter several hundred such instruments were sold by the plaintiff to the defendant, Oppenheimer, and beginning with the summer of 1926 such instruments were sold to the other defendant, Contoure Laboratories, Inc., to which the business of Oppenheimer had been transferred, said Oppenheimer being President of this corporation and directing its affairs in all dealings with the plaintiff and all matters relating thereto. This purchase of such instruments continued until all orders had been filled in the fall of 1927. At that time the defendants, and each of them, refused to buy more of such instruments from the plaintiff and instead of giving the plaintiff the business formerly given to him, the business was placed elsewhere and thereupon several hundred such instruments were made by a party or parties unknown to the plaintiff and furnished to the defendants upon the order of the defendants and such instruments have been used and sold by the defendants acting in conspiracy to defraud and defeat [fol. 5] the rights of the plaintiff in the premises. The exact number of such infringing instruments is unknown to the plaintiff, but, on information and belief, he alleges that several hundred at least of such instruments have been so made, used and sold in defiance of his rights.

7. That the plaintiff, Edward Becker, duly notified the defendants of his said Letters Patent No. 1,634,316 dated July 5, 1927, and warned them not to infringe the same in accordance with the statute in that case made and provided. This notice was given on or about August 13, 1927.

8. Plaintiff, Edward Becher, is informed and believes and therefore avers, that the said defendants, Contoure Laboratories, Inc., and Herbert Oppenheimer, well knowing the premises and the rights secured to the plaintiff, as aforesaid, since the date and issue of said Letters Patent, and prior to the filing of this suit, within the Southern District of New York, as well as elsewhere throughout the United States, without right or license from the plaintiff, and in defiance thereof, has been, now is, and is threatening to continue to infringe upon said Letters Patent, and to violate plaintiff's rights thereunder, by selling and offering for sale, using and offering for use, and by causing, assisting and encouraging others to manufacture for sale and use, massaging irons embodying and containing the improvements described and claimed in said Letters Patent, and particularly by selling, offering for sale, and threatening to continue to do so, massaging irons manufactured by unknown [fol. 6] parties, as aforesaid, containing and embodying the improvement and invention described and claimed in said Letters Patent No. 1,634,316, whereby the said defendants, Contoure Laboratories, Inc., and Herbert Oppenheimer, conspiring and confederating together, have realized large gains, profits, benefits and advantages which should and otherwise would be received and obtained by the plaintiff, except for defendant's unlawful acts.

9. That on or about the 22nd day of September, 1927, the defendants brought a suit against the plaintiff in the Supreme Court of the State of New York, Kings County, File No. 23237/27 alleging that the invention of the said Becher patent was made by said Oppenheimer and disclosed by him confidentially to Edward Becher and that Becher fraudulently took out a patent which is now the patent here in suit for the invention of Oppenheimer and demanded judgment as follows:

"Wherefore, plaintiffs demand judgment: (1) declaring the defendant a trustee on his own wrong for the benefit of the plaintiff, Contoure Laboratories, Inc., as assignee of said Oppenheimer, of the said invention and the letters patent issued to the defendant under No. 1,634,316; and any and all modifications and improvements thereof; (2) that the defendant be enjoined and restrained from using, manu-

facturing, selling, hiring out or otherwise using, distributing or disposing of any of said instruments or any part thereof or modification thereof; (3) that the defendant be enjoined [fol. 7] and restrained from transferring, assigning, and granting any rights, licenses or privileges under said letters patent, or to such instruments or any similar instrument, instruments or parts or modifications thereof; (4) that the defendant be directed to deliver up to the plaintiffs all instruments and parts thereof now in his possession; (5) that the damages to the plaintiffs be ascertained and the defendant be directed to pay the same; and (6) that the plaintiffs have such other and further relief as to the Court may seem just and proper, together with the costs and disbursements of this action."

That the defendants well knew that the allegations of the complaint were untrue and fraudulent and that they were not entitled to the relief sought.

10. This plaintiff further alleges that the said defendants, Contoure Laboratories, Inc., and Herbert Oppenheimer, well known that the issue of originality as to the said Becher patent in suit involves the validity of the aforesaid Becher patent here in suit No. 1,634,316 and so resorted to the Patent Office by way of an amendment of an earlier application of said Oppenheimer, filed on June 26, 1926, Serial No. 118,637 and amended the same on or about August 31, 1927, and in view of a copy of the Letters Patent in suit which had been disclosed to the defendants and each of them earlier in the month of August, 1927, by the plaintiff Becher and until after this disclosure, the defendants made no effort to claim the invention of the Becher patent [fol. 8] as the invention of Oppenheimer, all this claim being an afterthought with a view to fraudulently putting the plaintiff Becher to additional expense and trouble; that pursuant to the amendment so filed, which copied the claims of this Becher patent in suit, an interference was duly instituted between the parties, the senior party being the patentee Becher, plaintiff in this suit, and the junior party being the defendant corporation, assignee of the application of said Herbert Oppenheimer. That upon the declaration of said interference, the defendants forthwith resorted to dilatory tactics so as to prevent this interference from being heard or decided and they have been suc-

cessful in this so that said interference is still pending undetermined in the Patent Office.

11. That the said defendants have prosecuted their said suit in the Supreme Court of the State of New York, King's County, to the extent of getting a preliminary injunction restraining the plaintiff herein, Edward Becher, pursuant to the prayer of the complaint above quoted, and testimony has been taken before a Referee and the case is now pending undetermined by him. That upon the argument of the motion for a preliminary injunction in said suit in Kings County, the plaintiff herein, Edward Becher, made a counter motion to have the complaint dismissed on the ground that the contest between the parties is one involving the issue of the Patent Office interference and the decision of this issue dominates and controls the decision of [fol. 9] the Court. This motion was denied and the proceedings were had before the Referee, over the protest of Edward Becher, who objected to the jurisdiction of the Referee for the foregoing reasons. That the said proceedings in the said State Court were fraudulently instituted and fraudulently prosecuted on the part of the defendants herein for the purpose of harrassing and oppressing the plaintiff herein in a Court without jurisdiction.

Plaintiff therefore prays:

1. For a writ of subpœna ad respondendum against the defendants, Contoure Laboratories, Inc., and Herbert Oppenheimer, according to the practice of the Courts of Equity;

2. For a writ of injunction, preliminary as well as perpetual, restraining these defendants, their associates, successors, agents, employees, workmen and co-conspirators and each and every person or concern in privity with them, or either of them, from infringing or continuing or threatening to infringe said Letters Patent;

3. For an accounting of the profits and damages resulting from said infringement;

4. For a writ of injunction, preliminary as well as perpetual, restraining these defendants from further prosecuting their suit in the Supreme Court of the State of New

York, Kings County, against this plaintiff, File No. 23237/27, and directing defendants to consent to a dismissal of this suit upon such terms as this Honorable Court may direct;

[fol. 10] 5. For an accounting of the damages caused plaintiff resulting from the bringing of said suit, the costs of defending the same by plaintiff and any other damages or costs or disbursements necessarily incurred by the plaintiff in defending such suit or resulting therefrom; and

6. For the costs of this suit, and for such other and further relief as to this Honorable Court may seem just.

Edward Becher. O. Ellery Edwards, Solicitor for Plaintiff.

Duly sworn to by Edward Becher. Jurat omitted in printing.

[fol. 11] In United States District Court

[Title omitted]

Order to Show Cause—July 6, 1928

Upon the Bill of Complaint herein, the affidavit of Edward Becher, verified the 6th day of July, 1928, and the Exhibits therein referred to and pending further order of this Court,

Let the defendants, Contoure Laboratories, Inc., and Herbert Oppenheimer, be restrained from in any way taking any action to enforce any judgment in the case now pending between the parties in the Supreme Court of Kings County, No. 23237/27, or in any other way enforcing or causing to be enforced this judgment or any rights thereunder against the plaintiff herein, Edward Becher. This restraining order is granted because the plaintiff Becher is directed to assign his patent in suit to the defendant Oppenheimer on or before Tuesday next, as appears from his affidavit. He claims that the order directing him so to [fol. 12] assign his patent was entered without jurisdiction and therefore illegally and is null and void. To pro-

tect the jurisdiction of this Court pending further inquiry and determination, this restraining order is signed.

It Is Further Ordered that the defendants and each of them show cause why the preliminary relief prayed for in paragraphs 2 and 4 of the Bill of Complaint herein, should not be granted, the preliminary injunction asked in paragraph 2 being limited to claims 1 and 4 of the patent in suit.

It Is Further Ordered that service of a copy of this order, the bill of complaint herein, the affidavit of Edward Becher, verified the 6th day of July, 1928, and Exhibits 1, 3, 4, 5, 6 and 7 attached thereto, upon Moers & Rosenschein, Esq'rs., attorneys for defendants, on or before the 7th day of July, 1928, shall be good and sufficient service and notice hereof.

It Is Further Ordered that this case be placed at the head of the motion calendar to be heard the 10 day of July, 1928.

Wm. Bondy, U. S. D. J.

[fol. 13] In United States District Court

[Title omitted]

Affidavit of Edward Becher

In a Suit About to Be Commenced

State of New York,
County of New York, ss:

Edward Becher, being duly sworn, deposes and says: I am the plaintiff in the above entitled case and I am familiar with the facts and circumstances connected therewith.

I further depose and say that I identify Exhibit 1, attached hereto, as my patent in suit No. 1,634,316.

I further identify a massaging machine made in accordance with this patent by me and it is a sample of what I made for the defendants and upon their order. I identify this as Exhibit 2.

I further depose and say, on information and belief, that within the last few months and since the date of my said

Letters Patent in suit, the defendants have infringed my patent and particularly claims 1 and 4 thereof, by manufac- [fol. 14] turing such structures of which Exhibit 2 is a sample.

I further depose and say that an order has been served on my counsel and a proposed assignment providing for an assignment of my patent to the defendant Oppenheimer. I believe that this assignment is improper and that the Court has no jurisdiction enabling it to order such an assignment and that its order directing such an asignment is utterly null and void. I make this statement on the advice of my counsel, who advised me that under the Constitution of the United States and the laws made pursuant thereto, the entire and exclusive jurisdiction in patent suits involving the validity of a patent is vested in the United States Courts and that the State Courts are forbidden to function therein. I understand that a State Court can direct the transfer of a title to a patent, but it cannot pass on the validity of a patent to say whether or not a patent is valid or invalid. In the suit in the State Courts referred to in the Bill of Complaint herein, the complaint alleges that I received the idea of my patent here in suit from one Oppenheimer, and appropriated the same and went in the Patent Office and took out the patent, which is now the patent in suit aforesaid, see paragraphs 9 and 10 of the complaint, a copy of which is annexed hereto and made a part hereof. In paragraph 11 I am accused of perjury.

I deny each and all of these allegations in the complaint as shown by my answer, a copy of which is annexed hereto [fol. 15] and made a part hereof. A copy of the complaint I identify as Exhibit 3, and a copy of the answer as Exhibit 4.

It will be seen from the foregoing that the issue between the parties is a question of originality. I claim that I made the invention and derived no knowledge of any kind from Oppenheimer. Oppenheimer claims that he originated the invention and that I copied from him. I understand that this is an interference matter of a well known type in the Patent Office, where such issues of originality are frequently tried in Patent Office interferences.

Oppenheimer filed an application in June, 1926, and after he saw my patent he copied my claims and made a supplemental oath. I annex hereto and make a part hereof a copy of the drawing of this application as Exhibit 5. A copy of the declaration of interference now pending undetermined between us, I annex hereto and make a part hereof as Exhibit 6.

From the foregoing it is apparent that a decision of the State Court suit depends entirely on the question of origin of invention and that is the exact matter in issue in the Patent Office interference. That the decision of the State Court in holding that I fraudulently appropriated the invention of Oppenheimer and took out a patent therefor, is a decision holding that my patent is invalid because Oppenheimer is the prior inventor thereof and thereby passes directly on the validity of my patent. I am advised by counsel that such a decision by a State Court is unconstitutional, contrary to the laws of the United States and ut [fol. 16] terly null and void and therefore pursuant to this advice, I file this Bill of Complaint, I make this affidavit and I ask for the relief requested by my counsel.

I further depose and say that the judgment of the State Courts for $1,195.85 and the interference with my business, is the great hardship.

I attach a copy of this judgment hereto as Exhibit 7.

Edward Becher.

Sworn to and subscribed before me this 6th day of July, 1928. Stella Holtzmann, Notary Public, Kings County. Kings Co. Clerk's No. 270, Reg. 385. N. Y. Co. Clerk No. 730, Reg. 0-482. Commission expires March 30, 1930. (Seal.)

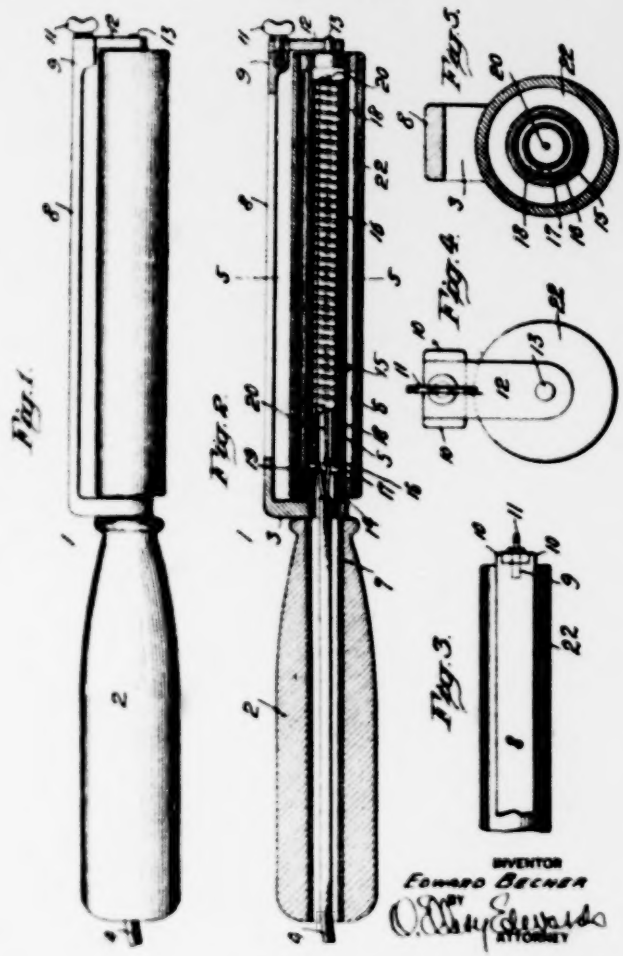
Exhibit 1 to Affidavit of Edward Becher

(Here follows affidavit marked side folio pages 16a, 16b, and 16c)

July 5, 1927. E. BECHER 1,634,316

MASSAGING HEATING ROLLER

Filed March 27, 1926



INVENTOR
EDWARD BECHER
BY
ATTORNEY

Patented July 5, 1927. 1,634,316

UNITED STATES PATENT OFFICE.

EDWARD BECHER, OF NEW YORK, N. Y.

MASSAGING HEATING ROLLER.

Application filed March 27, 1926. Serial No. 97,043.

The object of my invention is to provide a roller of this class which can be heated without giving too intense a heat and which can be rolled over the flesh of a patient while held by a handle. More particularly the invention involves a structure wherein the electric heating parts are fixed relatively to the handle so that there are no sliding contacts. This object is accomplished by my invention, one embodiment of which is hereinafter more particularly set forth.

For a more particular description of my invention, reference is to be had to the accompanying drawings, forming a part hereof, in which

Figure 1 is a side elevation of a tool embodying my improvement.

Figure 2 is a longitudinal section of the same.

Figure 3 is a plan view of a portion of this instrument.

Figure 4 is an enlarged end view of the same, and

Figure 5 is an enlarged section, taken on the line 5—5 of Figure 2.

Throughout the various views of the drawings, similar reference characters designate similar parts.

My improved massaging tool or instrument 1 is composed of a handle 2, a frame 3 on which the handle is mounted, an electric conductor with two wires 4, a heating element 5 with a cylindrical wall and a roller 6 with internal flanges revolving on the exterior of the heating element.

The handle 2 may be made of any desired shape and size and it is hollow to receive the hollow tang 7 of the frame 3. At one end of the handle this frame extends laterally until clear of the roller 6 and then it runs parallel to the roller 6, as shown at 8, to its enlarged end 9. This enlarged end has two projections 10 and a screw threaded hole adapted to receive a thumb screw 11 which passes through the removable end 12 of the frame 3. This end 12 is perforated to receive a lug 13 which is fixed to one end of the heating element 5.

The conductor 4 runs through a boss 14 which is fixed in one end of a cylinder 15 of the heating element and the lug 13 is at the other end of this cylinder. This cylinder is lined with an insulator, such as asbestos 16, and inside this and concentric with it is another asbestos or similar cylinder 17 and between these two cylinders is a spiral heating element 18 with its ends connected to conductors 19 and 20, the end 19 being connected to the end of the spiral next to the handle 2 and the conductor 20 extending through the center of the cylinder 17 to the end remote from the handle 2 and there joins the spiral 18 with which it is preferably made integral. The joint of the wire 20 is preferably made near the handle 2.

The roller 6 has internal end flanges 21 which may be made integral with the cylindrical part of this roller and these flanges turn freely on the cylindrical surface 16 of the heating element. An air space 22 is preserved between the roller 6 and cylinder 15. The frame 3 with its laterally extending parts, one next to the handle 2 and the other the end 12, keeps the roller 6 on the cylinder 15.

In view of the foregoing, the use of my instrument will be readily understood. Assuming electric energy is turned on to the heating element through the conductor 4 and the same is heated, this heat radiates out through the asbestos or other lining 16 and is conducted through the cylinder 15, which is preferably made of brass, or similar heat conducting material, and from thence is passed through the air space 22 to the cylinder 6 which is never overheated because of the air space. Once the roller 6 is sufficiently warm, it is rolled over the surface to be massaged, back and forth, as much as desired, and if necessary any liniment or other material may be spread on this surface before this rolling so as to cause the same to be absorbed by the skin of the patient. When the massaging is ending, the current may be shut off from the conductors 4 and 5 the operation continued for several minutes because the roller 6 will continue to be hot for a time during the cooling heating element.

While I have shown and described one embodiment of my invention, it is obvious that it is not restricted thereto, but that it is broad enough to cover all structures that come within the scope of the annexed claims.

Having thus described my invention, what I claim is:

1. A massage instrument comprising a hollow handle, a U-shaped frame secured to

said handle, a heating element fixed to said handle and projecting longitudinally therefrom and a roller mounted rotatably upon said heating element and restrained by said frame from longitudinal movement.

2. A massage instrument, a heating element with an exterior, cylindrical surface, a roller with an air space mounted rotatably on said cylindrical surface and means for keeping the roller from shifting longitudinally.

3. A massage instrument, a hollow handle with a frame secured thereto, a heating element fixedly mounted in said frame, a roller rotatably mounted on said heating element and prevented from excessive longitudinal movement by said frame.

4. A massage instrument, a handle, a frame with a hollow shank passing through said handle, an electric heating element fixedly mounted in said frame and having a cylindrical outer surface and means for supplying said heating element with electricity and a cylindrical roller with internal flanges resting on and turning on said heating element so that an air space is preserved between the greater portion of said roller and said heating element, whereby the roller will function at a suitable temperature.

5. A massage instrument comprising a handle, a heating element carried by said handle, a frame also carried by said handle and a removable outer portion upon said frame for assisting in supporting said heating element.

6. A massage instrument comprising a handle, a heating element carried by said handle, a frame also carried by said handle, a roller carried by said heating element, a removable outer portion upon said frame for assisting in supporting said heating element and maintaining said roller upon said heating element.

7. A tool of the class described comprising a handle, a heating element fixed to said handle and extending longitudinally from one end thereof and a roller mounted rotatably upon said heating element and having the greater portion thereof spaced from said heating element.

In testimony whereof, I have hereunto set my hand this 23d day of March, 1926.

EDWARD BECHER.

[fol. 17] EXHIBIT 3 TO AFFIDAVIT OF EDWARD BECHER

(State Court Case No. 23237/27. Complaint dated September 22, 1927.)

Plaintiffs, by Moers & Rosenschein, their attorneys, complaining of the defendant herein, respectfully allege:

1. That at all times hereinafter mentioned, plaintiff Contoure Laboratories, Inc., was and now is a domestic corporation.

2. That at all times hereinafter mentioned and for some time prior to 1925, the defendant was a machinist and owned and operated a machine shop.

3. That for a long time prior to March, 1926, plaintiff, Herbert Oppenheimer, was engaged in inventing a certain instrument designated by him as an "apparatus for promoting osmotic absorption" or an "ozmosifier iron."

4. That several months prior to the month of March, 1926, said plaintiff Oppenheimer engaged the defendant as a machinist to make certain mechanical parts of said instrument, for which said plaintiff Oppenheimer agreed to pay defendant.

5. That thereafter, said plaintiff Oppenheimer modified and improved his said invention, the said instrument, from time to time and engaged the defendant to make various mechanical parts of said instrument as modified and improved.

[fol. 18] 6. That at the time of engaging the said defendant as a machinist, said plaintiff Oppenheimer and the defendant agreed that the defendant as a machinist would from time to time do certain work for the said plaintiff Oppenheimer under the instruction and direction of said plaintiff, for the purpose of making models to be used in application by said plaintiff for letters patent, for which said plaintiff agreed to pay to the defendant, and the defendant would keep secret and confidential such information and knowledge as he would obtain from said plaintiff in the course of such instruction and direction by said plaintiff and in the course of the services rendered and work done by the defendant as a machinist in that connection.

7. That at the time of originally engaging the defendant to make said mechanical parts and from time to time thereafter, said plaintiff Oppenheimer necessarily disclosed to the defendant his said inventions and the modifications and improvements thereof, his ideas originating the same, the manner of making the same, the novelty thereof and all its various parts, the use to which the same might be put, the commercial value thereof and various methods of manufacturing the same and combining the elements of novelty.

8. That in or about the month of February, 1926, said Oppenheimer necessarily disclosed to said defendant in order to enable him at the request of said plaintiff Oppenheimer to manufacture certain parts thereof, an improved [fol. 19] instrument conceived by the said Oppenheimer, which consisted of a heating element composed of asbestos and wire, enclosed in a brass tube and the whole thereof enclosed in an aluminum roller which rotated around the brass tube, itself stationary and connected or attached to a wooden handle with a metal frame or top bar over the roller, the heating element in the brass tube being connected with a wire running through the wooden handle intended to be connected with a source of electric energy such as a socket.

9. That without the knowledge or consent of the plaintiffs or either of them, and in or about the month of March, 1926, while he was thus engaged in making mechanical parts for said plaintiff Oppenheimer and after ascertaining from said plaintiff Oppenheimer the ideas, facts and information above set forth and all the facts concerning the said invention of plaintiff Oppenheimer and the modification and improvements thereof, the defendant appropriated to his own use said ideas and said invention and the modification and improvements thereof, and in violation of his agreement, made application to the Commissioner of Patents of the United States for letters patent upon the said instrument by application known as Serial No. 97862.

10. That on or about the 27th day of March, 1926, said defendant filed in the United States Patent Office, a petition, specification of claims and oath upon said application for letters patent bearing Serial No. 97862, which application

[fol. 20] was granted and letters patent issued to said defendant bearing No. 1,634,316.

11. That in said petition, specification, claims and oath the defendant falsely stated that he had invented said instrument; that he was the original, first and sole inventor thereof; that he did not know and did not believe that the same was ever known or used before his alleged invention or discovery thereof.

12. That said statements were false and untrue in that the defendant had misappropriated the knowledge obtained by him from plaintiff Oppenheimer during the course of his employment as machinist; that he had not invented said instrument; that he was neither the original nor the first nor the sole inventor thereof; that he knew and believed that the same was known and used before his alleged invention or discovery thereof, namely, by the said plaintiff Oppenheimer, who to the knowledge of the defendant was the inventor thereof, and that defendant knew that all of his said statements were false and untrue.

13. That the letters patent thus applied for by the defendant and issued to him were for an instrument consisting of a heating element composed of abestos and wire enclosed in a brass tube, the whole thereof enclosed in an aluminum roller which rotates around the brass tube, itself stationary and connected or attached to a wooden handle with a metal frame or top bar over the roller, the heating element in the brass tube being connected with a wire running through [fol. 20] the wooden handle intended to be connected with a source of electric energy such as a socket.

14. That on or about the 23rd day of June, 1927, said Oppenheimer duly assigned, transferred and set over unto the plaintiff herein all his right, title and interest in and to said instruments, inventions and modifications and improvements thereof, and the sole and exclusive right thereto and all letters patent then or thereafter issued thereon.

15. That until on or about the 15th day of August, 1927, neither the plaintiffs nor either of them had any knowledge either of said application by the defendant for said letters patent or of the issuance of said letters patent to the defendant.

16. That without such knowled[illegible], the plaintiff continued until the discovery of the existence of said application for and issuance of said letters patent, to procure the defendant to manufacture for it the instruments invented by said plaintiff Oppenheimer.

17. That immediately upon discovering the existence of said application for and the issuance to the defendant of said letters patent, plaintiffs demanded that the defendant discontinue making any instruments pursuant to the letters patent issued to the defendant, or similar thereto, or modifications or improvements thereof, and demanded that the defendant transfer, set over and assign to said Oppenheimer or the plaintiff all his right, title and interest in [fol. 22] and to said letters patent issued in the name of the defendant, which the defendant refused to do.

18. That plaintiffs have established a substantial trade in the instruments above described in connection with the use of certain preparations and are daily engaged in selling large quantities of preparations and hiring out instruments for use in connection therewith and have invested large sums of money in the manufacture and distribution thereof.

19. That defendant threatens to manufacture and sell and has manufactured and sold instruments such as are described in said letters patent issued to him, to the irreparable injury of the plaintiff and said Oppenheimer.

20. That the plaintiffs have no adequate remedy at law.

Wherefore, plaintiffs demand judgment: (1) declaring the defendant a trustee ex his own wrong for the benefit of the plaintiff Contoure Laboratories, Inc., as assignee of said Oppenheimer, of the said invention and the letters patent issued to the defendant under No. 1,634,316; and any and all modifications and improvements thereof; (2) that the defendant be enjoined and restrained from using, manufacturing, selling, hiring out or otherwise using, distributing or disposing of any of said instruments or any part thereof or modification thereof; (3) that the defendant be enjoined and restrained from transferring, assigning, and granting any rights, licenses or priveleges under said letters patent, or to such instruments or any similar in-

[fol. 23] strument, instruments or parts or modifications thereof; (4) that the defendant be directed to deliver up to the plaintiffs all instruments and parts thereof now in his possession; (5) that the damages to the plaintiffs be ascertained and the defendant be directed to pay the same; and (6) that the plaintiffs have such other and further relief as to the Court may seem just and proper, together with the costs and disbursements of this action.

Moers & Rosenschein, Attorneys for Plaintiffs, 280 Madison Avenue, New York City.

City, County and State of New York, ss:

Herbert Oppenheimer, being duly sworn, deposes and says: I am one of the plaintiffs in this action and President of Contoure Laboratories, Inc., the other plaintiff in this action. I have read the foregoing complaint and know the contents thereof. The same is true of my own knowledge.

Herbert Oppenheimer.

Sworn to before me, this 22nd day of September, 1927. Betty Levine, Notary Public, Kings County. Clerk's No. 340, Reg. No. 8411. N. Y. Co. Clerk's No. 926, Reg. No. 8117-A. Bronx Co. Clerk's No. 94, Reg. No. 2861-E. Commission expires March 30th, 1928.

[fol. 24] Exhibit 4 to Affidavit of Edward Becher

(State Court Case No. 23237/27. Amended and supplemental answer. Dated December 2, 1927.)

Defendant for his Amended and Supplemental Answer to Plaintiff's Complaint alleges:

First. He denies the allegations in paragraphs designated 1, 4, 5, 6, 7, 8, 9, 11, 12, 16, 17 and 20 of plaintiffs' complaint contained.

Second. He denies any knowledge or information sufficient to form a belief as to the allegations in paragraphs designated 3, 14, 15 and 18 of plaintiffs' complaint contained.

Third. He admits the allegations in paragraph designated 19 of plaintiffs' complaint contained except that he denies that part thereof which reads "to the irreparable injury of the plaintiff and said Oppenheimer."

For a First Separate and Complete Defense

Fourth. That on or about the 5th day of July, 1927, Letters Patent No. 1,634,316, with seven claims allowed and incorporated therein, was published and issued to the defendant by the United States Patent Office on an application filed by defendant on the 27th day of March, 1926; which Letters Patent covered Massaging Heating Rollers.

Fifth. Upon information and belief, that on or about [fol. 25] the 26th day of June, 1926, the plaintiff Oppenheimer filed, in said Patent Office, an application for Letters Patent for a Method and Apparatus for Promoting Osmotic Absorption.

Sixth. Upon information and belief that the plaintiff Oppenheimer, after the publication referred to in paragraph Fourth hereof, and because of having seen that publication, filed in said Patent Office an amendment to his said application adding thereto and seeking the allowance thereunder of seven additional claims, which seven additional claims were copied word for word from the aforesaid seven claims of defendant's said Letters Patent.

Seventh. That on or about October 19, 1927, and upon information and belief as the result of the amendment aforesaid, said Patent Office declared an interference between defendant's said Letters Patent and a then pending application of plaintiff Oppenheimer for Letters Patent; and upon information and belief, that said pending application so placed in interference with defendant's Letters Patent aforesaid is the application of the plaintiff Oppenheimer referred to in paragraph Fourth hereof.

Eighth. Upon information and belief that on or about June 23, 1927, before the commencement of this action, the plaintiff Oppenheimer duly assigned, transferred and set over unto the plaintiff corporation all his right, title and interest in and to the invention claimed in his said application [fol. 26] so declared in interference with defendant's afore-

said Letters Patent, and modifications and improvements thereof, and the sole and exclusive right thereto and all Letters Patent issued thereon.

Ninth. That the said interference is now pending and undetermined.

Tenth. That such interference is for the same cause as set forth in the complaint herein.

For a Second Separate and Complete Defense

Eleventh. Defendant repeats and realleges the allegations in paragraphs designated "Fourth," "Fifth," "Sixth," "Seventh," "Eighth," "Ninth" and "Tenth" of the First Separate and Complete Defense contained.

Twelfth. That this court has not jurisdiction of the subject of this action which is a patent matter.

Wherefore defendant demands judgment dismissing plaintiffs' complaint and awarding defendant the costs and disbursements of this action.

Edwards & Henry, Attorneys for Defendant. Office & P. O. address: 233 Broadway, Borough of Manhattan, New York City.

[fol. 27] State of New York,
County of New York, ss:

Edward Becher, being duly sworn, says that he is the defendant in the above entitled action; that he has read the foregoing answer and knows the contents thereof; that the same is true of his own knowledge except as to the matters therein stated to be alleged upon information and belief and that as to those matters he believes it to be true.

Edward Becher.

Sworn to before me this 2nd day of December, 1927. Floyd M. Sheffield, Notary Public, Nassau County. N. Y. Co. Clerk 981, Register 9728. Queens Co. Clerk 2501, Register 4840. Commission expires March 30, 1929.

Exhibit 5

Drawing of Oppenheimer application in interference. See Exhibit 6, p. 28 for declaration of interference. For specification of the Oppenheimer application see Exhibit 2 attached to this affidavit, record, page 63.

(Here follows Exhibit 5, marked side folio page 27a)

[fol. 28] Exhibit 6 to Affidavit of Edward Becher

Declaration of interference between Herbert Oppenheimer application Exhibit 2 attached to the Oppenheimer affidavit (Record, page 63) and the patent of Edward Becher No. 1,634,316 granted July 5, 1927. This interference was declared October 25, 1927, No. 55956.

The case, above referred to, is forwarded to the Examiner of Interferences because it is adjudged to interfere with others, hereafter specified. The question of priority will be determined in conformity with the Rules. The interference will be identified as No. 55956. On or before Nov. 21, 1927, the statement demanded by rule 110 must be sealed up and filed with the subject of invention, and name of party filing it, indorsed on the envelope. The subject-matter involved in the interference is.

Count 1

A massage instrument comprising a hollow handle, a U-shaped frame secured to said handle, a heating element fixed to said handle and projecting longitudinally therefrom and a roller mounted rotatably upon said heating element and restrained by said frame from longitudinal movement.

Count 2

A massage instrument, a heating element with an exterior, cylindrical surface, a roller with an air space [fol. 29] mounted rotatably on said cylindrical surface and means for keeping the roller from shifting longitudinally.

FIG. 1.

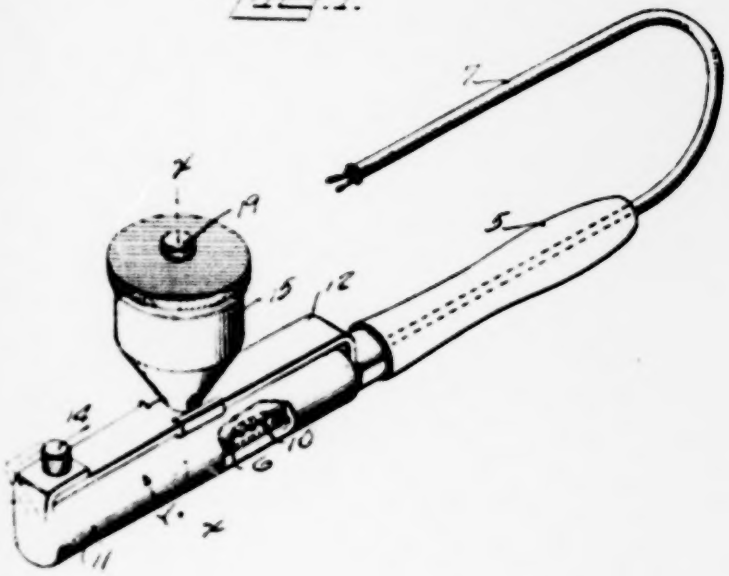


FIG. 2.

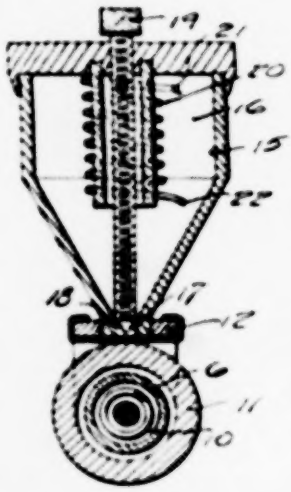
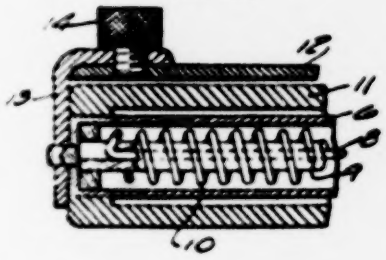


FIG. 3.



Herbert Oppacher INVENTOR

Count 3

A massage instrument, a hollow handle with a frame secured thereto, a heating element fixedly mounted in said frame, a roller rotatably mounted on said heating element and prevented from excessive longitudinal movement by said frame.

Count 4

A massage instrument, a handle, a frame with a hollow shank passing through said handle, an electric heating element fixedly mounted in said frame and having a cylindrical outer surface and means for supplying said heating element with electricity and a cylindrical roller with internal flanges resting on and turning on said heating element so that an air space is preserved between the greater portion of said roller and said heating element, whereby the roller will function at a suitable temperature.

Count 5

A massage instrument comprising a handle, a heating element carried by said handle, a frame also carried by said handle and a removable outer portion upon said frame for assisting in supporting said heating element.

Count 6

A massage instrument comprising a handle, a heating [fol. 30] element carried by said handle, a frame also carried by said handle, a roller carried by said heating element, a removable outer portion upon said frame for assisting in supporting said heating element and maintaining said roller upon said heating element.

Count 7

A tool of the class described comprising a handle, a heating element fixed to said handle and extending longitudinally from one end thereof and a roller mounted rotatably upon said heating element and having the greater portion thereof spaced from said heating element.

This interference involves the patent above identified and an application of——

Herbert Oppenheimer, 53 West 72nd Street, New York, N. Y., for Method and Apparatus for Promoting Osmotic Absorption, whose attorney is George H. Benjamin, 25 West 43rd Street, New York, N. Y.

The relation of the counts of the interference to the claims of the respective parties is as follows:

Counts	Becher	Oppenheimer
1	1	6
2	2	7
3	3	8
4	4	9
5	5	10
6	6	11
7	7	12

Counts compared.

——— ———, Examiner, Division 43.

[fol. 31] Exhibit 7 to Affidavit of Edward Becher

(State Court Case No. 23237/273

Judgment

The above entitled action having been commenced by the service of the summons personally upon the defendant, and the defendant having appeared and answered herein, and the issues joined having been referred to Honorable Russell Benedict, Official Referee, to hear and determine by order made by Honorable Harry E. Lewis, one of the Justices of this Court, which order was dated December 19, 1927, and was entered in the office of the Clerk of Kings County on December 19, 1927, and said issues having been tried on the 16th day of February, 8th day of March and 7th day of June, 1928, and after hearing all the evidence adduced by the respective parties, said Official Referee having made his decision herein in writing dated June 29th, 1928, and which said decision was duly filed in the office of the Clerk of Kings County on the 3rd day of July, 1928.

Now, on motion of Moers & Rosenzchein, attorneys for the plaintiffs, it is

Adjudged that the defendant, Edward Becher, is and ever since March, 1926, has been trustee ex maleficio for the **benefit plaintiff, Herbert Oppenheimer, of the invention and letters patent issued by the Commissioner of Patents of the United States to the defendant herein under No. 1634316 and any and all modifications and improvements thereof, and it is further**

Adjudged that within five days after service of notice of entry of this judgment upon the attorneys for the de- [fol. 32] fendant, the said defendant Edward Becher deliver to the plaintiffs, or to their attorneys, Moers & Rosenschein, at the office of said Moers & Rosenschein, 280 Madison Avenue, Borough of Manhattan, City of New York, an assignment of patent in the form of the proposed assignment hereto annexed and marked Exhibit A, executed and acknowledged by said defendant, and it is further

Adjudged that said defendant be and he hereby is forever enjoined and restrained from using, manufacturing, selling, hiring out or otherwise using, distributing or disposing of any instruments described in or similar to the instrument or invention referred to in said letters patent or any parts thereof or modifications or improvements thereof, and it is further

Adjudged that the defendant be and he hereby is forever enjoined and restrained from transferring, assigning or granting any rights, licenses or privileges under said letters patent, or to such instruments or any similar instruments or parts or modifications or improvements thereof, and it is further

Adjudged that within said period of five days after service of notice of entry of this judgment upon the attorneys for the defendant, the defendant deliver up to plaintiff, Herbert Oppenheimer, or to Moers & Rosenschein, attorneys for plaintiffs at the office of said Moers & Rosenschein, 280 Madison Avenue, Borough of Manhattan, City of New York, all such instruments and parts thereof now in his possession, and it is further

Adjudged that the plaintiffs recover of the defendant, Edward Becher, $195.85 costs of this action as taxed to- [fol. 33] gether with the sum of $1,000.00 extra allowance

to the plaintiffs, in all the sum of $1,195.85 and that the plaintiffs have execution thereof.

Judgment entered this 5th day of July, 1928,

William E. Kelly, Clerk.

Approved as to form. Russell Benedict, Official Referee of the Second Judicial Department.

EXHIBIT A TO EXHIBIT 7

Whereas, I, Edward Becher, residing at 1310A Myrtle Avenue, in the Borough of Brooklyn, City and State of New York, did obtain Letters Patent of the United States for an improvement in Massage Heating Roller, which Letters Patent are No. 1634316 and bear date the fifth day of July, 1927, and

Whereas, judgment was entered in the Supreme Court of the State of New York, Kings County directing me to transfer, set over and assign to Herbert Oppenheimer of Borough of Manhattan, City of New York, said Letters Patent,

Now, therefore, to whom it may concern, be it known, that pursuant to the provisions of said judgment, I the said Edward Becher have transferred, set over and assigned and by these presents do transfer, set over and assign unto said Herbert Oppenheimer, the whole right, title and in- [fol. 34] terest in and to the said improvement in Massage Heating Roller, and in and to the Letters Patent therefor aforesaid; the same to be held and enjoyed by said Herbert Oppenheimer for his own use and behoof and for the use and behoof of his legal representatives to the full end of the term for which said Letters Patent are or may be granted as fully and entirely as if the same would have been held and enjoyed by me had this assignment not been made.

In witness whereof, I have hereunto set my hand and affixed my seal at the Borough of Brooklyn, City and State of New York, this — day of ——, 1928.

——— (L. S.)

In the Presence of: ——— ———.

State of New York,
County of Kings,
City of New York, ss:

On this — day of ——, 1928, before me came Edward Becher, to me known and known to me to be the individual described in and who executed the within assignment and he duly acknowledged to me that he executed the same.

In United States District Court

Memorandum of Judge Mack

Memorandum on cover of Order to Show Cause filed July 6, 1928, as follows:

"Filed July 6th, 1928, at 3.37 P. M.
Motion Denied.

J. W. M., U. S. C. J."

7/10/28.

[fol. 35] In United States District Court

Affidavit of Herbert Oppenheimer—Filed July 11, 1928

State of New York,
County of New York,
City of New York, ss:

Herbert Oppenheimer, being duly sworn, deposes and says, I am one of the defendants herein, and am President of Contoure Laboratories, Inc., the other defendant herein.

As appears from the pleadings a judgment has been entered in the Supreme Court of the State of New York, Kings County in an action wherein the defendants herein were plaintiffs and the plaintiff herein was defendant, declaring plaintiff herein trustee ex maleficio of the patent which is the subject of this action for the benefit of defendant, Oppenheimer and compelling plaintiff herein to transfer said patent to said Oppenheimer by assignment.

The judgment of the State Court also enjoins the plaintiff herein from exercising any rights under said patent.

The plaintiff obtained knowledge of the facts upon which he based his application for patent during the course of his employment by me as a machinist to make certain parts of a massage instrument for me in creating the models necessary to procure letters patent thereon, and generally to perfect the same. The plaintiff misappropriated the knowledge thus obtained and secretly procured the letters patent mentioned in his bill of complaint in his own name.

Before I met the plaintiff, I had actually made a complete model of the instrument and was contemplating modi- [fol. 36] fications thereof. This instrument was wholly my own conception and idea and invented solely by myself. The modifications which I contemplated were my own conception and idea and I was the sole inventor thereof. I then required a machinist to make mechanical parts to carry out certain of my conceptions and ideas. On December 18th, 1925, I went to the place of business of the plaintiff, who had been recommended to me as a machinist. I told him that I had invented an instrument and exhibited to him the one which had actually been made, and explained to him that I had conceived a method of modifying and improving it. He said that such an instrument was new to him and that I would have to explain to him in detail what I wanted done. I told him that this invention was entirely my own and that I would like him to do some mechanical work for me upon models which were necessary so that I could obtain a patent and also for the purpose of experimenting and improving the instrument.

I told him that I would want him to make mechanically the various parts which I would describe to him from time to time and which I desired to use in connection with the instrument as I would modify and improve it from time to time. I explained to him that these parts as well as the whole instrument both in process of development and as completed must be restricted to my own use and that it would be necessary for me to trust him with my secret ideas and conceptions concerning the same, in order to enable him to make the various parts mechanically. [fol. 37] He thereupon assured me that I could trust him entirely and that he would keep the matter confidential.

Accordingly, in exhibiting to him the model that I had already made, I pointed out to him that this instrument was intended to be electrically heated and used in the application of certain preparations of which I owned the formulas, upon the face and body. The instrument in its then state consisted of a casing and handle containing three rollers, two of them on either end to be heated and the third or center one to be used in applying the preparation.

Prior to meeting plaintiff, I had procured another machine firm to make up the original model. On September 22nd, 1925, I engaged the Interstate Mechanical Laboratories of 521-531 West 57th Street, New York City, to make the mechanical parts of the instrument upon which I was then experimenting. From that time until November 21, 1925, these experiments continued and for a period of nine weeks I paid to the Interstate Mechanical Laboratories, $70 or $80 each week for labor performed on the model and its changes. In all I paid that concern $676.70.

On November 3rd, 1925, when the model was substantially completed, I engaged a patent attorney for the purpose of procuring letters patent. This was Mr. George Hillard Benjamin of 25 West 43rd Street, New York City.

On November 24th, 1925, a draftsman was engaged to [fol. 38] prepare the drawings necessary upon the application for letters patent. On December 10th, 1925, I actually signed the application for letters patent which were filed in the United States Patent Office on December 18th, 1925. All these things occurred before I ever met the defendant. A copy of my petition, specification claims and oaths filed on my behalf on December 18th, 1925, given serial number 76276 is hereto annexed and marked Exhibit 1.

It was only after these things had been done that I went to the plaintiff to engage him as a machinist. What I said to plaintiff at that time was not that I had a patent but that an application for patent was pending. On that day I delivered the model to the plaintiff, for which he gave me the following receipt. From that receipt it appears that the plaintiff was engaged in the business of "general repairs of links and links knitting machines and plain drive and automatic attachments made." The receipt is as follows:

[fol. 39] "Telephone Evergreen 8182

Edward Becher, General Repairs of Links & Links Knitting Machines, also Plain Drive and Automatic Attachments Made, 1206 Myrtle Avenue, Brooklyn, N. Y.

Dec. 18, 1925.

H. Oppenheimer, 205 E. 44th St.:

Received for estimating purposes 1 oznosifier iron—and is to be returned on Mon. Dec. 21/25.

(Signed) Edward Becher.

Except for the signature and the letterhead portion, the receipt is in my handwriting.

He returned with the estimate on December 22nd, 1925, when I gave him the order, a copy of which is as follows:

[fol. 40] "Slendaform Laboratories, 205 East 44th Street, New York

Vanderbilt 2861

Mr. Edward Becker, 1310 Myrtle Avenue, Brooklyn, N. Y.

Dear Sir: We herewith give you our order for ten (10) irons, patented by us, under the following conditions:

The cost to us for each iron is to be Fifteen Dollars ($15.00).

We agree to pay for them when they are finished and delivered to us.

They are to be delivered in about two (2) weeks from the date of this order.

The ownership of all castings, dies, patterns, special tools etc. are to revert to us when we have bought and paid for fifty (50) irons, irrespective of the lower price we may pay for them in the future. The above mentioned castings, dies, patterns and special tools, etc., refer to those only made and used by you in the manufacture of our iron.

The iron is to be made of aluminum, except those parts, as indicated on the model that are made of brass. This does not include the casing around the plug, which is to be made of aluminum.

[fol. 41] The iron is to be made exactly the same as the sample or model furnished, with the following exceptions as to details.

The openings in the preparation chamber of box are to be slightly smaller (a hair's breadth).

The ends are to be made thicker so the handle will fit into a slot, instead as at present, (on the outside). The handle is also to be slightly higher and thicker, so that a better grip is possible.

Box lock is to be improved so it will be more efficient.

A notch or tread is to be used on the middle hollow tube, so that it will lock and not leak.

The frame is to be slightly wider so as to make room for a thicker asbestos.

There is to be a collar or finish of some kind around the edge of the tube, where the heating wire comes through to be joined at the top. This wire is to be encased in a tubing or covered in some practical manner. All electrical parts are to be insulated 100%.

Yours very truly, (Signed) Herbert Oppenheimer.

Accepted.
(Signed) Edward Becher.

At that time I was doing business under the firm name of Slendaform Laboratories. The foregoing order was prepared entirely by myself and the instructions as to the details of manufacture as therein stated were prepared by [fol. 42] myself. Not only did Becher make no suggestion on the subject, but as he now admits, he knew nothing about the machine or its purpose.

Some time in January, these ten machines were delivered. I immediately asked him to make 25 more. While he was making those 25, I tried the first ten and discovered that the heating irons did not work properly. There was not a steady supply of heat. Very soon the other 25 instruments were ready. I went to the plaintiff and asked him to make a change in all 35 instruments. This was without suggestion from him.

I told him that for a long time I had had another idea as to the method of heating the rollers and that I would instruct him as to the changes which I desired made upon the irons which he had already manufactured. I told him that

what I wanted at that time was that he make new rollers for me, different from the ones which were contained in those irons, namely:

The heated rollers in the instrument already made consisted of an aluminum roller and above it a brass tube containing a heating element consisting of wire and asbestos. The aluminum roller rotated against the brass tube containing the heating element. Now I desired to make a change as follows: Instead of having the brass tube containing the heating element on top of the aluminum roller, I asked him to make the identical brass tube with the identical heating element contained therein, the whole enclosed in the aluminum roller instead of above it, and I explained to him the [fol. 43] manner in which I desired the brass tube connected to the electric wire, and in what way I wanted the aluminum roller placed so as to rotate around the brass tube.

While these irons were being altered, I experimented further and conceived the idea and was the sole inventor of a further improvement and modification of the iron, consisting simply of reducing the instrument to a single roller and handle.

The single roller instrument was merely a reduction in size of the instrument already manufactured for me by the plaintiff. It eliminated two of the rollers and confined the instrument to a single roller. This occurred about the middle of February. I have definitely ascertained this date from consulting the records of George H. Benjamin, my patent attorney, from which it appears that on February 9, 1926, I called on him for the purpose of requesting him to make a second application for patent, this one covering the single roller instrument. From that time on, I experimented with the single roller instrument, and the plaintiff, at my request, and under my instructions made various forms of it. There are at least four of such models.

I instructed him as to the parts which I desired made and explained to him how I desired these parts made and fitted so that I would have a model for the purpose of obtaining a patent. Under my instruction, he made four separate [fol. 44] models from that time until about the middle of March, 1926. I instructed him how to make each of these models and told him how I wanted each of the mechanical parts constructed.

The instrument as finally modified and improved consisted of a heating element composed of asbestos and wire enclosed in a brass tube and the whole thereof enclosed in an aluminum roller, which rotated around the brass tube, itself sationery and connected or attached to a wooden handle with a metal frame or top bar over the roller, the heating element in the brass tube being connected with a wire running through the wooden handle, intended to be connected with a source of electric energy, such as a socket.

From that time on I gave the defendant orders for large quantities of these instruments which he made in accordance with my said conception, idea and invention and the modifications and improvements thereof, conceived by myself. In instructing the plaintiff from time to time in the method of manufacturing the various parts of the instrument and the insturment itself, it was necessary for me to disclose to him my original ideas and conceptions, the method of making the instrument and its parts, the use to which it could be put and the novelty of the various ideas and conceptions. For his work and for such materials as he furnished from time to time I paid the plaintiff.

Of course I did not know while negotiating and discussing [fol. 45] the instrument and its parts with the plaintiff, that he was either contemplating or actually engaged in making application to the Commissioner of Patents of the United States for letters patent to himself covering this invention, the instrument, its modifications and improvements.

In the record of his application for letters patent, plaintiff made his prime claim that the instrument was one "having a construction such that the roller can be easily removed and replaced upon said heating element." This is an attribute of my machine in all its various forms beginning with my first model and ending with the one now in use.

It was just about the middle of March, 1926, when the single roller instrument was completed in a form which I considered satisfactory for use. On March 24th, the defendant gave me a bill, again on his letterhead, for the labor performed on the various modifications, and it is as follows:

[fol. 46] "Telephone Jefferson 4245

Edward Becher, General Machine Work of All Kinds of Knitting Machines, also Plain Drive and Automatic Attachments Made, 1310A Myrtle Avenue, Brooklyn, N. Y.

March 24, 1925.

Dr. Oppenheimer Laboratory, 205 E. 44th Street, New York City, 70 Special M. H. Rollers Made for 35 Ozmosifier Irons

Labor 88½ hr.	$132 75
Aluminum 17 lb.	8 05
Brass 17 in.	4 85
Total	$145 65"

I have paid that bill in full.

I find from the records of Mr. Benjamin that I called at his office on March 27th, 1926, with respect to the application for letters patent on the single roller. This is the day on which without my knowledge, plaintiff filed his application for letters patent.

The situation was not then ripe for filing my own application for the following reason: It will be noted that the [fol. 47] frames on my instrument contain an opening in which there is a screw thread. This is intended to receive a cup containing the preparation to be applied to the skin by means of the roller. I was at that time experimenting with the kind of cup required and withheld the filing of the application until I had decided which cup to use. At various times I was considering a soft rubber cup, a metal cup and a hard rubber cup. Various forms of these cups were made for me by concerns who specialized in that work, the hard rubber cup being made by the New York Hard Rubber Turning Co., 212 Center Street, New York City, and the metal cups being made by Samuel H. Moss, 36 East 23rd Street, New York City. Finally I determined on the hard rubber cup and communicated that fact to Mr. Benjamin who was thereupon instructed to file application for letters patent in accordance with my prior request.

The papers upon this application were finally executed on June 8th, 1926, and filed by Mr. Benjamin on my behalf on June 26th, 1926. A copy of the petition, specification and oath is hereto annexed and marked Exhibit 2. Prior to filing this application, I never used or made public the single roller instrument.

From these copies it will be seen that the plaintiff knew nothing about this invention or its purpose, but merely copied what he had learned from me. The instrument for which he obtained letters patent is not so made as to allow the attachment of a cup containing the preparation to be [fol. 48] applied to the skin. In other words, the purpose of the instrument was so that the preparation could be so supplied to the instrument as not to require the use of the hands or fingers in the application to the skin. By my invention, the preparation is placed in the cup attached to the instrument and the preparation drips through on to the roller. The instrument for which letters patent were issued to the plaintiff omits this feature, a most important feature of the whole invention. Of course I did not disclose to the plaintiff that I proposed to have such a cup and to avoid the use of fingers in applying the preparation to the skin. For that reason it is apparent that the plaintiff did not know what he was about in copying my invention.

This distinction can readily be seen from the copies of the drawings hereto annexed. Those marked Exhibits 3 and 4 are the ones used for my application for letters patent covering the three roller instrument. The one marked Exhibit 5 was used by me on my application for letters patent covering the single roller. It will be seen that in both applications there is a provision for a chamber to contain the preparation to be applied to the skin. In the first instance, it is a box containing perforations through which the preparation passes. In the second, it is a cup containing an opening. In each instance the intention is that the preparation pass immediately on to the roller without the necessity of using the hands in the application.

[fol. 49] By June, 1926, the plaintiff modified the description of the business in which he was engaged. He gave me the following acceptance of an order for machines on a letterhead, as indicated below, and with the words stricken out as indicated. But he did not change his billheads.

"Telephone Jeffe[illegible]n 4245

Edward Becher, General Machine Work of All Kinds of [Knitting]* Machines, also [Plain Drive]* and Automatic Attachments Made, 1310A Myrtle Avenue, Brooklyn, N. Y.

June 2, 1926.

Dr. Herbert Oppenheimer, 205 West 44th Street, New York City:

Undersigned accepted from Dr. Oppenheimer an order of 200 massage rollers, as per sample, at price of $4.47 each. Agreement is made that Dr. Oppenheimer supplies those rollers with ebony wood handles 8 ft. wire, stop off block and connecting block, two metal cups and heating element. The rest of roller is to be made and completed by—

(Signed) Edward Becher."

[fol. 50] In the interim and even thereafter, the rollers were changed from time to time. After numerous ones were made by the defendant, I finally asked him to make two rollers for each machine so that they might be interchanged, one of them smooth with knurled parts and the other entirely knurled. I always paid him for the labor which he performed and either supplied him with the material or paid him for it.

In January, 1927, he apparently considered that he had advanced further for he gave me the following acceptance of order with the letterhead changed by striking out words as indicated:

"Telephone Jefferson 4245

Edward Becher, General Machine Work [of All Kinds of Knitting Machines, also Plain Drive and]* Automatic Attachments Made, 1310A Myrtle Avenue, Brooklyn, N. Y.

Jan. 3, 1927.

Contoure Laboratories, Inc., 6 West 48th Street, N. Y. C.

Dear Sirs: The new cost price of the Massage Roller will be, in the future, $8.90 which includes complete machine.

[*Erased in copy.]

[*Words enclosed in brackets erased in copy.]

[fol. 51] The following will be furnished by you as before: 2 preparation cups, heating element, ebony wood handle, wire and necessary plugs.

Machine will be completed by us at the price agreed upon.

Very truly yours, (Signed) Edward Becher."

The Court will note that plaintiff had nothing to do with making or furnishing the cup. He merely manufactured part of the instrument which was my own invention.

This evolution process of plaintiff's occupation was occasioned merely by the fact that I had been imparting to him the facts concerning the various modifications of my invention.

During all this period he kept secret his application for letters patent in his own name.

Of course since discovering the facts that the plaintiff had obtained letters patent, neither myself nor any other person associated with the defendants gave the plaintiff any orders. I then realized that the plaintiff had procured these letters patent upon an invention belonging to me and that it would be dangerous to give him further orders.

While the plaintiff had no experience whatsoever with instruments of this kind, I on the other hand had been engaged in making and using machines of a like nature for over twenty years. My business during all that period was chemicals and I was always concerned with making [fol. 52] machines with which the chemicals could be used.

From time to time during that period I was experimenting with various machines that could be used in connection with the application of chemical preparations.

The notion of having a single roller in place of the three which I had originally planned was merely the final outgrowth of a long series of experiments. My original model was soon found to be too burdensome for use, especially since it was necessary to instruct owners of small beauty parlors as to the manner in which the instruments should be used. I finally decided that instead of having the three-roller instrument for use upon all parts of the body, that it would be more practical to have a single roller and confine its use to applying preparations to the face.

Plaintiff's application for letters patent was a surreptitious and fraudulent act on the part of the plaintiff, in violation of his duty to your deponent and his agreement not

to use for his own benefit or to misuse or divulge the secrets and new ideas, conceptions and inventions of deponent.

In June, 1926, I became interested in the defendant, corporation, Contoure Laboratories, Inc., with certain third persons. I thereupon transferred to the defendant corporation my said inventions, improvements and modifications thereof and all my right, title and interest therein and thereto.

[fol. 53] Defendant corporation has been engaged in business since June, 1926, and its business consists solely of renting out these instruments and selling the preparations to be used in connection therewith.

That the defendant corporation has made substantial investment and incurred substantial liabilities in connection with its business. The investment in cash alone is $40,000 besides the value of various patent rights, formulas and the like.

The defendant corporation has spent about $20,000 on a publicity campaign and has obligated itself to an advertising consultant for $7,500 per year, and has contracted for advertising for $5,000. It is at present spending about $1,500 per month for advertising. In addition, it has outstanding approximately 1,000 instruments, and has many more in the process of manufacture.

An injunction would cause the defendants irreparable injury. On the other hand plaintiff has not done anything toward manufacturing, marketing or exploiting the instrument, he merely has the intention to do so. His only reason for that is because defendants ceased doing business with him in August, 1927, as hereinbefore set forth. A denial of an injunction would cause him no substantial injury.

Furthermore, there is now pending in the Patent Office an interference declared by the Commissioner of Patents between the patent issued to plaintiff in his own name and [fol. 54] application of defendant Oppenheimer filed June 26, 1926.

Wherefore deponent prays that the motion made herein be in all respects denied.

Herbert Oppenheimer.

Sworn to before me this 10th day of July, 1928.

Exhibit 1 to Affidavit of Herbert Oppenheimer

Petition

To the Commissioner of Patents:

Your Petitioner, Herbert Oppenheimer, a citizen of the United States of America, and residing at New York City, in the County and State of New York, and whose post-office address is 53 West 72nd Street, New York City, prays that Letters Patent may be granted to him for Method and Apparatus for Promoting Osmotic Absorption set forth in the annexed specification; and he hereby appoints George H. Benjamin, Registeree No. 594, of 25 West 43rd Street, New York City, attorney, with full power of substitution and revocation to prosecute this application to make alterations and amendments therein, to receive the patent, and to transact all business in the Patent Office connected therewith.

Inventor's full name: Herbert Oppenheimer.

[fol. 55] Specification

To all whom it may Concern:

Be It Known, That I, Herbert Oppenheimer, a citizen of the United States of America, and residing at New York City, in the County and State of New York, and whose post office address is 53 West 72nd Street, New York City, have invented a Method and Apparatus for Promoting Osmotic Absorption of which the following is a specification:

My invention relates to a method and apparatus for promoting osmotic absorption of medicinal preparations through the skin, into the blood and tissues. Osmotic absorption of medicinal preparations, as unusually practiced, consists in spreading the medicinal preparations on the surface of the skin, and then, through the hand, rubbing such preparations into the skin. As thus practiced, osmotic absorption is very slow and further, objectionable, as many of the medicinal preparations used tend to stain and soil the hands, and further, bring about osmotic absorption by the person making the application, and in the case where the application is made by a physician or a nurse, of different preparations, the effect upon such physician or nurse is frequently very unfortunate.

My invention, therefore, consists in a method and means by reason of which medicinal preparations may be applied [fol. 56] to the skin, and osmotic absorption materially increased without the disadvantages mentioned above.

The accompanying drawings will serve to illustrate one form of apparatus which may be employed. I wish it understood, however, that the form and details of construction of the apparatus may be materially modified, without departing from my invention.

In the drawings, Fig. 1 is a view in perspective showing the general relation of the parts.

Fig. 2 is a transverse vertical section taken on line 2-2 of Fig. 1.

Fig. 3 is a longitudinal horizontal section taken on line 3-3 of Fig. 2.

Fig. 4 is a vertical elevation and partial section of the receptacle for the medicinal preparation.

Fig. 5 is a perspective view of a distributing roller, with the parts partially separated.

In the drawings, 5 indicates the enclosing frame, open at the bottom, 6, and at the top 7. Mounted below the bottom of the frame are three rollers, 8, 9 and 10. The rollers, 8 and 9 are pivoted at each end in the links, 11, which links have formed in them at the upper end, slotted openings, 12, in which are located thumb screws, 13, the inner threaded ends of which are located in threaded openings in the ends of the frame. The purpose of this arrangement is to provide for vertical adjustment of the rollers, 8 and 9, relative to the bottom of the frame. It will be understood that the bottom of the rollers 8 and 9 may be in line, as shown in Fig. 1, or may project beyond the bottom of the roller, [fol. 57] 10, and thus the bottom of the rollers form a concave line, or alternatively, the bottom of the rollers 8 and 9 are adjusted, above the bottom of the roller, 10, and thus form a convex line.

The roller, 10, is also mounted in links, 14, attached to the ends of the frame, and held thereto by a thumb screw, 15. The roller, 10, may also be made adjustable to and from the frame, if desired.

Situated within the frame is a receptable, 16, for the medicinal preparation to be applied, See Fig. 4. The bottom of this receptacle is perforated, as shown at 17, to permit the medicinal preparation to be moved outward from

the bottom of the receptacle. The receptacle, 16, is provided with a cover, 18, which is adapted to be held in position by bails, 19, and pivoted at 20, and provided at the top with a set screw, 21. By shifting the bails to the position shown in dotted lines, Fig. 4, the cover may be removed. Located within the receptacle, and conforming to the shape of the receptacle is a presser plate, 22, which is adapted to be located over the medicinal preparation (indicated at 23, Fig. 2), and which has for its purpose to press the medicinal material out of the receptacle through the openings, 17, as desired. This is accomplished by means of an adjusting screw, 24, loosely secured to the presser plate and movable in a threaded sleeve, 25, secured in the cover, 18. Secured to the top of the sleeve, 25, is a hand screw, 26. By rotating the hand screw, and through it, the sleeve, the presser plate, 22, can be moved up or down in [fol. 58] the receptacle, 16, as desired.

Located on each side of the frame and above the rollers 8 and 9 are electric heating units, 27, see Fig. 3, which units are connected to a connecting receptacle, 28, on the upper part of one side of the frame, which connecting unit may be connected to any suitable plug, in turn connected to a source of electric energy, not shown. If desired, a resistance device, not shown, may be included in the attaching cord so as to modify the heating effects of the heating units, 27. These heating units are suitably insulated as shown at 29, from the frame, by asbestos or otherwise.

The roller, 10, may be solid or may be hollow, and where hollow, as shown in Fig. 5, may be in two parts, and connected by a screw device.

The purpose of making the roller, 10, hollow is to permit the introduction into the roller of a hot or cold body of any description, as may be required, to effect proper distribution of the material fed to this roller through the openings, 17, of the receptacle, 16. If the medicinal preparation which it is desired to use is viscoid, it is often desirable to put a hot medium in the roller, 10, for instance, hot water. If, on the other hand, it is over fluid, it is often desirable to increase its viscidity by using a cold body in the roller, 10.

Pivotally connected to the top of the frame is a handle 30, and to hold this handle in the position shown in Fig. 1, a [fol. 59] pivoted latch, 31, is provided at each end. By turn-

ing these latches upward the handle is released and can then be carried into the position shown in dotted lines of Fig. 2.

The method of operating the apparatus described and promoting osmotic absorption is as follows: The rollers 8 and 9 are first adjusted in accordance with the surface to which the medicinal preparation is to be applied, if a flat surface, with the bottom of the rollers in line; if a convex or concave surface, with the bottoms arranged accordingly. The medicinal preparation is then introduced into the receptacle, 16, and finds its way through the opening, 17, into the surface of the roller, 10. The electric current is then turned into the heaters, 27. The heat generated is transmitted to the medicinal preparation, and also indirectly to the rollers 8 and 9, and through the rollers 8, 9 and 10, to the skin and tissues. The operator then takes the device in his two hands, his thumbs passing under the handle, 30, at the ends, and moves it over the surface to which the medicinal preparation is to be applied. The effect is first to distribute the medicinal preparation over the surface, and simultaneously to heat and to manipulate, by raising and lowering through the action of the rollers, the skin and integument below the skin. The roller, 10, effects an even distribution of the medicinal preparation, and by the heating and manipulation of the skin and integument, due to the movement of the device over the skin and tissues, attracts the blood of the body to the surface of the skin and [fol. 60] integument, and thus establishes a relation between the skin and the blood and fluids below the skin and the medicinal preparation on the outside of the skin, the skin being the osmotic membrane whereby the medicinal preparation is rapidly absorbed by the tissues and the blood, thereby immensely increasing not only the amount, but the rapidity of osmotic action, over that which is possible where the old method previously stated is employed.

My improved device may be constructed of any metal, preferably aluminum, or the frame may be of aluminum and the receptacle of glass, or other material which will not be affected by the medicinal preparations employed.

Having thus described my invention, I claim:

Claims

1. The method for promoting osmotic absorption described, which consists in applying to the skin a layer of a

medicinal preparation and simultaneously heating and manipulating the skin and tissue below the layer.

2. The method for promoting osmotic absorption described, which consists in applying to the skin a layer of a medicinal preparation and simultaneously heating and mechanically manipulating the skin and tissue below the layer.

3. The method for promoting osmotic absorption described, which consists in applying to the skin a heated [fol. 61] layer of a medicinal preparation and simultaneously heating and mechanically manipulating the skin and tissue below the layer.

4. An apparatus for the purpose described, comprising a frame, a plurality of rollers mounted below the frame, means for adjusting one or more of the rollers, relative to the frame and a receptacle for a medicinal preparation, having a perforated bottom located within the frame, over and in proximity to one of the rollers.

5. The combination of elements described in Claim 4, with the addition of means for heating the rollers, the receptacle and the medicinal preparation carried therein.

6. The combination of elements described in claim 5, with the addition of a cover for said receptacle and an adjustable presser plate within the receptacle.

7. The combination of elements set forth in claim 6, with the addition of a pivoted handle, and means for holding said handle in a vertical position, relative to the frame.

8. The combination of elements recited in claim 6, with a device on the exterior of the frame by which electrical connection may be made with a source of electric energy.

9. An apparatus for the purpose described, consisting of a frame, a plurality of rollers located below the frame, one of said rollers hollow and formed of two detachable sections.

[fol. 62] 10. In an apparatus of the class described, the combination of a receptacle for a fluid medicinal preparation, said receptacle having a perforated body, a roller mounted below the bottom of said receptacle, in relation

thereto, together with means for exerting pressure upon the medicinal preparation in the receptacle, whereby such preparation will be forced through the perforations, and progressively onto the surface of the roller mounted below the perforations.

In testimony whereof, I affixed my signature in the presence of two witnesses.

Herbert Oppenheimer.

Oath

City of New York,
County of New York,
State of New York, ss:

Herbert Oppenheimer, the above named petitioner, being duly sworn, deposes and says that he is a citizen of the United States of America, and resident of New York City; in the County of New York, State of New York; that he verily believes himself to be the original, first and sole inventor of the improvement in Method and Apparatus for Promoting Osmotic Absorption described and claimed in the annexed specification; that he does not know and does not believe that the same was ever known or used before his invention or discovery thereof, or patented or described [fol. 63] in any printed publication in any country before his invention or discovery thereof, or more than two years prior to this application, or in public use or on sale in the United States for more than two years prior to this application; that said invention has not been patented in any country foreign to the United States on an application filed by him or his legal representatives or assigns more than twelve months prior to this application; and that no application for patent on said improvement has been filed by him or his representatives or assigns in any country foreign to the United States.

Herbert Oppenheimer.

Sworn to and subscribed before me, this tenth day of December, 1925. K. L. Sullivan.

EXHIBIT 2 TO AFFIDAVIT OF HERBERT OPPENHEIMER

Petition

To the Commissioner of Patents:

Your Petitioner, Herbert Oppenheimer, a citizen of the United States of America, and residing at New York City, in the County and State of New York, and whose post-office address is 53 West 72nd Street, New York City, pray that Letters Patent may be granted to him for Method and Apparatus for Promoting Osmotic Absorption set forth in [fol. 64] the annexed specification; and he hereby appoints George H. Benjamin, Registered No. 594, of 25 West 43rd Street, New York City, attorney, with full power of substitution and revocation to prosecute this application, to make alterations and amendments therein, to receive the patent, and to transact all business in the Patent Office connected therewith.

Inventor's full name: Herbert Oppenheimer.

Specification

To all whom it may concern:

Be it known, that I, Herbert Oppenheimer, a citizen of the United States of America, and residing at New York City, in the County and State of New York, and whose post office address is 53 West 72nd Street, New York City, have invented a Method and Apparatus for Promoting Osmotic Absorption of which the following is a specification:

My invention relates to a method and apparatus for promoting osmotic absorption of medicinal preparations through the skin into the blood and tissues. Osmotic absorption of medicinal preparations, as usually practiced, consists in spreading the medicinal preparations on the surface of the skin, and then, through the hand, or by means of a roller, rubbing such preparations into the skin.

As thus practiced, osmotic absorption is very slow, and [fol. 65] further, objectionable, as many of the medicinal preparations used tend to stain and soil the hands, and further, bring about osmotic absorption by the person making the application, and in the case where the application is

made by a physician or nurse, of different preparations, the effect upon such physician or nurse is frequently very unfortunate.

My invention, therefore, consists in a method and means by reason of which medicinal preparations may be applied to the skin, and osmotic absorption materially increased, without the disadvantages mentioned above.

The accompanying drawings will serve to illustrate one form of apparatus which may be employed. I wish it understood, however, that the form and details of construction of the apparatus may be materially modified, without departing from my invention.

In the drawings: Fig. 1 is a view in perspective of my improved apparatus, the view being broken away to show an internal heating tube, and also showing in dotted lines at the left, the mechanism employed, by reason of which the roller may be removed for cleaning or otherwise.

Fig. 2 is a vertical section taken on line x-x of Fig. 1.

Fig. 3 is a longitudinal section taken on line y-y of Fig. 1.

In the drawings: 5 indicates a handle which is connected at its right hand end to a tubular heating unit, 6. 7 is an electric conductor connected at its terminals to the con- [fol. 66] ductors 8-9 of the resistance wire, 10, of the heating unit. 11 indicates a roller which is supported on the outside of the heating unit, 6, and which is free to revolve thereon. Supported upon the heating unit, 6, at the right hand end, and over the roller, 11, is a frame, 12. Pivotally connected to the left hand end of the heating unit, is a bracket, 13, the right hand end of which overlaps the top of the frame, 12, and may be secured thereto by the screw 14. Mounted on top of the frame, 12, in any suitable manner is a reservoir, 15, adapted to contain the medicinal preparation, 16, which is to be applied through the apparatus. The orifice, 17, at the lower portion of this reservoir is controlled by a needle valve, 18, which may be actuated by the screws 19 to control the delivery and flow of the medicinal preparation to the surface of the roller, 11. Located within the reservoir, 15, is a heating unit, 20, which has for its purpose to heat the medicinal preparation when desired. This heating unit is connected through the terminals 21-22 to the conductors leading through 7 to the source of electric energy.

The operation of my improved device will be readily understood. The medicinal preparation to be applied is introduced into the reservoir, and heated if desired. From the reservoir, it is fed upon the outer surface of the roller, 11, which roller is heated if desired, through the instrumentality of the heating unit, 6. Movement of the roller, 11, by hand or otherwise across the part to which the [fol. 67] medicinal preparation is to be applied insures a practically even distribution of the medicinal preparation over the part and its rapid osmotic absorption without involving the objections previously recited.

Having thus described my invention, I claim:

1. The method of promoting osmotic absorption which consists in progressively applying to the skin a layer of a medicinal preparation and simultaneously heating and manipulating the skin and tissue below the layer.

2. The method of promoting osmotic absorption which consists in progressively applying to the skin a heated layer of medicinal preparation and simultaneously heating and mechanically manipulating the skin and tissue below the layer.

3. An apparatus for the purpose described, comprising a handle, a heating unit, a roller mounted to revolve on the heating unit, a frame and a reservoir for a medicinal preparation mounted on the frame and over the roller.

4. The combination of the elements described in claim 3, with the addition of means for heating separately the medicinal preparation to be applied, and the roller for making the application.

5. The combination of elements described in claim 3, [fol. 68] wherein the frame is adjustable to permit removal of the roller.

In Testimony Whereof, I affix my signature, in the presence of two witnesses.

HERBERT OPPENHEIMER.

Oath

City of New York,
County of New York,
State of New York, ss:

Herbert Oppenheimer, above named petitioner, being duly sworn, deposes and says that he is a citizen of the United States of America, and resident of New York City; in the County of New York, State of New York; that he verily believes himself the original, first and sole inventor of the improvement in Method and Apparatus for Promoting Osmotic Absorption described and claimed in the annexed specification; that he does not know and does not believe that the same was ever known or used before his invention or discovery thereof, or patented or described in any printed publication in any country before his invention or discovery thereof, or more than two years prior to this application, or in public use or on sale in the United States for more than two years prior to this application; that said invention has not been patented in any country foreign to the United States on an application filed by him or his legal representatives or assigns more than twelve months prior [fol. 69] to this application; and that no application for patent on said improvement has been filed by him or his representatives or assigns in any country foreign to the United States.

HERBERT OPPENHEIMER.

Sworn to and subscribed before me this 8th day of June, 1926. Walter F. O'Donnell.

Exhibit 3

Drawing of Oppenheimer patent application filed December 18, 1925.

Exhibit 4

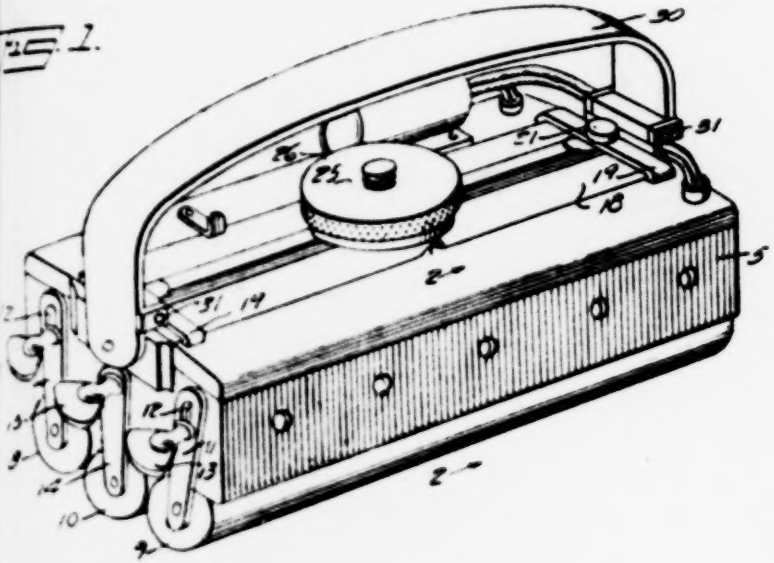
Drawing of Oppenheimer patent application filed December 18, 1925.

(Here follow Exhibits 3 and 4, marked side folio pages 69a and 69b)

EXHIBIT 3

69A

FIG. 1.



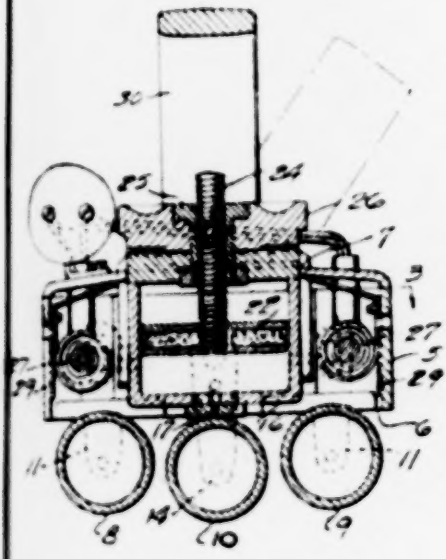
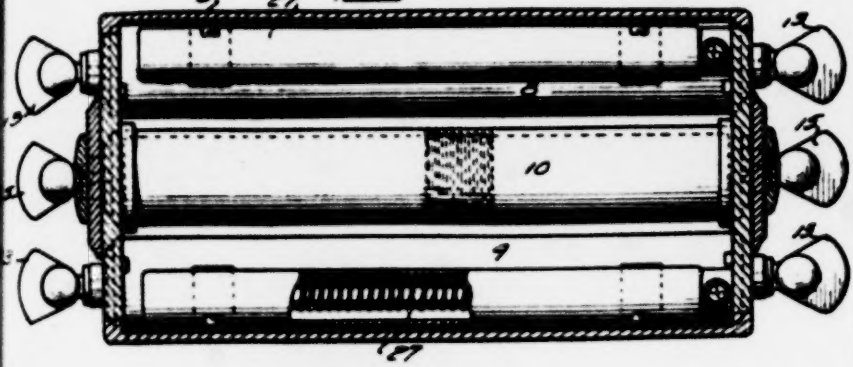


FIG. 2.

INVENTOR
Herbert Oppenheimer

FIG. 3.



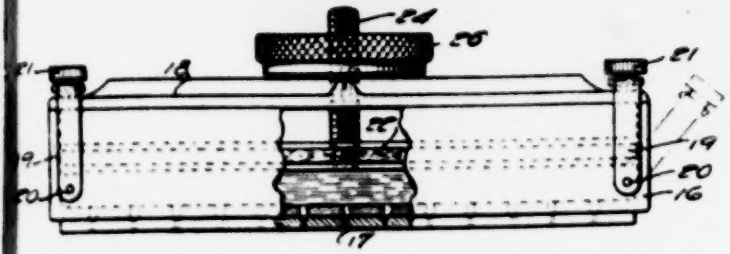


FIG. 4.

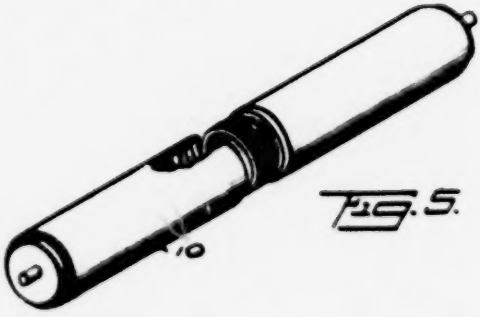


FIG. 5.

STATEMENT RE EXHIBIT 7 TO AFFIDAVIT OF HERBERT OPPENHEIMER

Exhibit 5 drawing, is the same as plaintiff's Exhibit 5 attached to the Becher affidavit above. See rec., p. 27.

[fol. 70] IN UNITED STATES DISTRICT COURT

ANSWER FILED JULY 11, 1928

Now come the Defendants, and for their answer to the bill of complaint allege:

1. They deny each and every allegation contained in paragraphs thereof marked 1, 4 and 7.

2. They deny that they have knowledge or information thereof sufficient to form a belief as to each and every allegation contained in paragraph thereof marked 2.

3. They deny each and every allegation contained in paragraph thereof marked 5, except that they admit that plaintiff made application to the Commissioner of Patents of the United States on March 27th, 1926, and that on July 5th, 1927, letters patent of the United States numbered 1,634,316 were issued to the plaintiff.

4. They deny each and every allegation contained in paragraph thereof marked 6, except that they admit that plaintiff manufactured certain heating rollers at their request.

5. They deny each and every allegation contained in paragraph thereof marked 8, except that they admit that they have sold, used and otherwise disposed of massaging irons embodying some of the elements referred to in said letters patent.

6. They deny each and every allegation contained in paragraphs thereof marked 9 and 11, except as hereinafter admitted.

7. They deny each and every allegation contained in paragraph thereof marked 10, except that they admit that a cer-

[fol. 71] tain interference is pending in the United States Patent Office between plaintiff and defendant Oppenheimer.

For a Separate Defense, Defendants Alleg:

8. That on or about the 23rd day of September, 1927, the defendants herein as plaintiffs commenced an action in the Supreme Court of the State of New York, Kings County, against the plaintiff herein as defendant, by service of a summons upon said defendant therein within the State of New York. That a copy of said summons is hereto annexed and marked Exhibit A.

9. That together with said summons, said plaintiffs therein served upon the defendant therein a complaint copy of which is hereto annexed and marked Exhibit B.

10. That together with said summons and complaint, plaintiffs therein served upon the defendant therein a notice of motion and affidavits upon an application by the plaintiffs therein for an order restraining and enjoining the defendant therein from exercising any rights under the letters patent bearing No. 1,634,316 referred to in the complaint herein, and from using, manufacturing, selling, hiring out or otherwise distributing or disposing of the instruments or any parts or modifications thereof; from transferring, assigning, granting any rights, licenses or privileges under said letters patent, or to such instrument or instruments [fol. 72] or parts or modifications thereof, and for other relief.

11. That thereafter and on September 28th, 1927, the defendant therein by his attorneys, Edwards & Henry, served notice of general appearance in said action.

12. That on the 29th day of September, 1927, the defendant therein served notice of motion for an order dismissing the complaint therein on the ground that it appeared on the face of the complaint (1) that the Supreme Court of the State of New York did not have jurisdiction of the subject of the action, and (2) that the complaint did not state facts sufficient to constitute a cause of action.

13. That said two motions came on to be heard together at a Special Term, Part I of the Supreme Court, Kings County, before Mr. Justice William B. Carswell.

14. That in opposition to the motion of the plaintiffs therein for an injunction, the defendant therein submitted an affidavit setting forth the facts asserted by the defendant on the merits of said action.

15. That after hearing said two motions, the Supreme Court of the State of New York, Kings County, by Mr. Justice William B. Carswell, rendered a decision in writing, a copy of which is hereto annexed and marked Exhibit C.

16. That thereafter an order was entered on October 21st, 1927, upon said two motions by the Supreme Court of the State of New York, Kings County, copy of which is [fol. 73] hereto annexed and marked Exhibit D.

17. That thereafter and on October 22nd, 1927, the defendant therein duly served his answer, a copy of which is hereto annexed and marked Exhibit E.

18. That thereafter and on the 2nd day of November, 1927, the defendant therein served notice of motion and affidavit and reargument of the two motions above referred to. That said motion for reargument came on to be heard at a Special Term, Part I of the Supreme Court of the State of New York, Kings County and was duly referred to Mr. Justice William B. Carswell.

19. That it is the custom of said Supreme Court of the State of New York to refer all motions for reargument to the Justice before whom the original hearing was had.

20. That after hearing the application for reargument, said Supreme Court, by Mr. Justice William B. Carswell, made a written decision, a copy of which is hereto annexed and marked Exhibit F.

21. That an order was thereafter and on November 16th, 1927, made by said Court denying said motion for reargument.

22. That the defendant therein had the right to appeal from said orders and each of them to the Appellate Division of the Supreme Court of the State of New York, Second Department, but failed to take such appeal from either or- [fol. 74] der, although the time to do so has long ago expired.

23. That thereafter each, the plaintiffs and the defendant therein, served due notice of trial in said action returnable at the November, 1927, term of Special Term, Part III of the Supreme Court of the State of New York, Kings County.

24. That thereafter and on December 2nd, 1927, the defendant therein served an amended and supplemental answer, copy of which is hereto annexed and marked Exhibit G.

25. That thereafter and on December 19th, 1927, an order was made on said action upon consent of all parties, referring the issues therein to Hon. Russell Benedict, Official Referee, to hear and determine, a copy of which order is hereto annexed and marked Exhibit H.

26. That thereafter said issue was duly noticed for trial before Hon. Russell Benedict, said Official Referee.

27. That said issue was thereafter duly tried before said Official Referee on February 16th, March 8th and June 7th, 1928.

28. That thereafter said Official Referee duly made a decision in writing, a copy of which is hereto annexed and marked Exhibit J, and which said decision was entered in the office of the Clerk of Kings County on July 3rd, 1928.

29. That thereafter and on the 5th day of July, 1928, judgment was duly entered in said action in the office of the Clerk of Kings County, copy of which is hereto annexed and [fol. 75] marked Exhibit K.

30. That in accordance with the laws in such cases made and provided, the defendant therein has an appeal as a matter of right from said judgment to the Appellate Division of the Supreme Court, Second Judicial Department.

For a second separate defense, the defendants allege:

31. That in and prior to the month of December, 1925, the plaintiff was engaged in the business of general repairs of Links and Links knitting machines.

32. That for a long time prior to December 18th, 1925, defendant Oppenheimer was engaged in inventing a massage machine.

33. That on the 18th day of December, 1925, said Oppenheimer filed in the office of the Commissioner of Patents at Washington, D. C., application for patent under Serial Number 76276 executed December 10th, 1925, for a massage machine.

34. That on or about the 18th day of December, 1925, said Oppenheimer engaged the plaintiff as a machinist to make certain mechanical parts of said machine for which said Oppenheimer agreed to pay plaintiff.

35. That at the time of and prior to said engagement of plaintiff by Oppenheimer, the latter informed plaintiff that he had then pending an application for patent upon [fol. 76] said massage machine.

36. That at the time of engaging plaintiff as a machinist, defendant Oppenheimer and plaintiff agreed that as such machinist, plaintiff would from time to time do certain work for said Oppenheimer under the instructions and directions of Oppenheimer both in duplication of the machine already made by Oppenheimer, for which application for patent was already pending and for improvements and modifications thereof in accordance with his said instructions and directions, for which Oppenheimer agreed to pay plaintiff, and said parties further agreed that plaintiff would keep secret and confidential such information and knowledge as he would obtain from Oppenheimer in the course of said instructions and directions and in the course of services rendered and work done by plaintiff as machinist in that connection, and that plaintiff would not use the same for his benefit or for the benefit of any one than said Oppenheimer.

37. That thereafter and from time to time Oppenheimer modified and improved said machine and invention and engaged plaintiff to make various mechanical parts of said machine and invention as modified and improved.

38. That thereafter Oppenheimer conceived a modification and improvement of said invention to the extent of placing certain brass rods containing heating elements inside certain aluminum rollers instead of on top thereof and

[fol. 77] inserting small separate end pieces in said rollers on which said brass rods should rest.

39. That thereafter and in or about the month of January, 1926, defendant Oppenheimer conceived and invented an improved massage machine hereinafter referred to and more particularly described.

40. That thereafter and in or about the months of January and February, 1926, Oppenheimer further engaged plaintiff and plaintiff agreed to do certain work for said Oppenheimer under his instructions and directions, in the making of models to be used in application by Oppenheimer for letters patent upon said improved massage machine, for which said Oppenheimer agreed to pay plaintiff, and plaintiff agreed to keep secret and confidential such information and knowledge as he would obtain from said Oppenheimer in the course of such instructions and directions and in the course of the services rendered and work done by the plaintiff as a machinist, and not to use the same for his own benefit or for the benefit of any one other than Oppenheimer.

41. That in or about the month of February, 1926, Oppenheimer engaged an attorney to file application on his behalf for letters patent upon said improved massage machine, which said application was thereafter and on June 26th, 1926, filed in the office of the Commissioner of Patents at Washington, D. C., under Serial No. 118637.

42. That at the time of originally engaging defendant to [fol. 78] do said work and from time to time thereafter, Oppenheimer relying upon the agreements aforesaid, necessarily disclosed to plaintiff his said inventions massage machine and improved massage machine, and the modifications and improvements thereof, his ideas originating the same, the manner of making the same, the novelty thereof and of all its various parts, the use to which the same might be put, the commercial value thereof, the various methods of manufacturing the same and combining the elements of novelty thereof.

43. That in or about the month of February, 1926, said Oppenheimer, relying upon the agreements aforesaid, necessarily disclosed to defendant in order to enable him at

the request of said Oppenheimer to make models and to manufacture certain parts thereof, said improved massage machine conceived by said Oppenheimer, which consisted of a heating element composed of asbestos and wire, enclosed in a brass tube, the whole thereof enclosed in an aluminum roller which rotated around the brass tube, itself stationary, and resting on two extra pieces of metal inserted in the ends of said roller, and connected or attached to a wooden handle with a metal frame or top bar over the roller, the heating element in the brass tube being connected with a wire running through the wooden handle intended to be connected with a source of electric energy, such as a socket.

44. That thereafter and under the instruction and direction of Oppenheimer, plaintiff made large quantities of said machines, all in accordance with the conception, ideas [fol. 79] and invention of said Oppenheimer.

45. That without the knowledge or consent of the defendants or either of them and in or about the month of March, 1926, while he was thus engaged in making massage instruments and mechanical parts for said Oppenheimer and after ascertaining from said Oppenheimer the ideas, facts and information above set forth and all the facts concerning the said invention and machines of Oppenheimer and the modifications and improvements thereof, plaintiff appropriated to his own use said ideas, said invention, machines and modifications and improvements thereof, and in violation of his agreement aforesaid and of the confidential relation between the parties, made application to the Commissioner of Patents of the United States in his own name for letters patent on said improved machine, by application known as Serial No. 97862.

46. That on or about the 27th day of March, 1926, plaintiff filed in the United States Patent Office a petition, specification, claims and oath under said application for letters patent bearing Serial No. 97862, which application was granted and letters patent issued to said plaintiff on or about July 5th, 1927, bearing No. 1,634,316.

47. That in said petition, specification, claims and oath the plaintiff falsely stated that he had invented said instrument; that he was the original, first and sole inventor

thereof; that he did not know and did believe that the [fol. 80] same was ever known or used before his alleged invention or discovery thereof.

48. That said statements were false and untrue in that the plaintiff had misappropriated the knowledge obtained by him from said Oppenheimer during the course of his employment as machinist; that he had not invented said instrument; that he was neither the original nor the sole inventor thereof; that he knew and believed that the same was known and used before his alleged invention or discovery thereof, namely, by the said Oppenheimer, who to the knowledge of the plaintiff was the inventor thereof, and that plaintiff knew that all of his said statements were false and untrue.

49. That the letters patent thus applied for by the plaintiff and issued to him were for a machine consisting of a heating element composed of asbestos and wire, enclosed in a brass tube, the whole thereof enclosed in an aluminum roller which rotated around the brass tube, itself stationary, and resting on two extra pieces of metal inserted in the end of said roller, and connected or attached to a wooden handle with a metal frame or top bar over the roller, the heating element in the brass tube being connected with a wire running through the wooden handle intended to be connected with a source of electric energy such as a socket.

50. That until on or about the 15th day of August, 1927, neither the defendants nor either of them had any knowledge either of said application by the plaintiff for said letters patent or of the issuance of said letters patent to the plaintiff.

[fol. 81] 51. That without such knowledge and until the discovery by the defendants of the existence of said application for and issuance of said letters patent, they continued to procure the plaintiff to manufacture for them the machines invented by said Oppenheimer.

52. That on or about the 23rd day of June, 1927, said Oppenheimer duly assigned, transferred and set over unto the defendant Contoure Laboratories, Inc., herein, all his right, title and interest in and to said instruments men-

tioned and modifications and improvements thereof, and the sole and exclusive right thereto and all letters patent then or thereafter issued thereon.

53. That immediately upon discovering the existence of said application for and the issuance to the plaintiff of said letters patent, defendants demanded that the plaintiff discontinue making any machines pursuant to the letters patent issued to the plaintiff, or similar thereto, or modifications or improvements thereof, and demanded that the plaintiff transfer, set over and assign to said Oppenheimer all his right, title and interest in and to said letters patent issued in the name of the plaintiff, which the plaintiff refused to do.

54. The defendants have established a substantial trade in the instruments above described in connection with the use of certain preparations and are daily engaged in selling large quantities of preparations and hiring out instruments for use in connection therewith, and have invested large sums of money in the use and distribution thereof.

[fol. 82] For a third separate defense, defendants allege:

55. That there is now pending and undetermined in the United States Patent Office an interference declared between the patent referred to in the bill of complaint herein issued to the plaintiff and an application for patent made by defendant Oppenheimer.

Wherefore, defendants demand judgment dismissing the bill of complaint herein, together with the costs of this action.

Moers & Rosenschein, Attorneys for Defendants, 280 Madison Avenue, New York City.

Duly sworn to by Herbert Oppenheimer. Jurat omitted in printing.

[fol. 83] EXHIBIT A TO ANSWER

SUPREME COURT OF THE STATE OF NEW YORK, KINGS COUNTY

File #23237/27

CONTOURE LABORATORIES, INC., and HERBERT OPPENHEIMER,
Plaintiffs,

against

EDWARD BECHER, Defendant

State Court Case No. 23237/27. Summons Dated September 22, 1927

To the above named defendant:

You Are Hereby Summoned to answer the complaint in this action, and to serve a copy of your answer, or, if the complaint is not served with this summons, to serve a notice of appearance, on the Plaintiff's Attorney within 20 days after the service of this summons, exclusive of the day of service; and in case of your failure to appear, or answer, judgment will be taken against you by default, for the relief demanded in the complaint.

Dated New York, Sept. 22, 1927.

Moers & Rosenschein, Attorneys for Plaintiffs. Office and Post Office address: No. 280 Madison Avenue, Manhattan, New York City.

STATEMENT RE EXHIBIT B TO ANSWER

State Court Case No. 23237/27. Dated September 22, 1927. Printed as Plaintiff's Exhibit 3. Rec., p. 17.

[fol. 84] EXHIBIT C TO ANSWER

Opinion rendered by Mr. Justice Carswell on original motion by plaintiffs for injunction pendente lite and by defendant to dismiss complaint (Law Journal 10/15/27) State Court case No. 23237/27

Contoure Laboratories, Inc., et al. v. Becher—Plaintiffs have moved for a temporary injunction, and the defend-

ants have moved to dismiss the complaint upon the grounds that the court has no jurisdiction of the subject of the action and that the complaint does not state a cause of action. The court has jurisdiction of this action (Lawton v. Ruthrauff & Ryan, Inc., 219 A. D. 267; Underhill v. Schenck, 238 N. Y. 7; Air Reduction Co., Inc., v. Walker, 118 Misc. 827; By-Products Recovery Co. v. Maybee, 288 Fed. 401; New Marshall Co. v. Marshall Engine Co., 223 U. S. 473). The case of Cheatham Electric Switching Device Co. v. Kentucky Switch & Signal Co. (213 Kentucky 23) is not to the contrary. In that case, at pp. 27 and 28, it appears that the plaintiffs' petition determined the character of the whole proceeding so far as jurisdiction was concerned, even though the counterclaim might have been subject to a different view if it could be considered freed from the effect of the petition upon the question of jurisdiction. The complaint herein is sufficient and the affidavits present a situation that requires a maintenance of the status quo pending a trial. This can only be accomplished by granting the injunction restraining the defendants, upon [fol. 85] the furnishing of a bond, the amount of which each side may submit a memorandum on limited to that question. Motion for injunction granted. Motion to dismiss the complaint or decline jurisdiction is denied.

EXHIBIT D TO ANSWER

Order of Justice Carswell, Dated October 21, 1927

State Court Case No. 23237/27

Motions made by the respective parties, namely, one by the plaintiffs for an injunction pendente lite, and the other by the defendant for an order dismissing the complaint herein on the ground that it appears on the face of the complaint that this Court has not jurisdiction of the subject of the action and that the complaint does not state facts sufficient to constitute a cause of action, made returnable October 4th, 1927, and having duly come on to be heard on October 7th, 1928,

Now, after reading the notice of motion dated September 22nd, 1927, the affidavit of Herbert Oppenheimer sworn to September 22nd, 1927, and Exhibit A thereto annexed, the affidavit of Edward Becher, sworn to September 28th, 1927, and Exhibit C annexed thereto, the affidavit of Herbert Oppenheimer, sworn to October 5th, 1927, and Exhibits 1, 2, 3, 4 and 5 thereto annexed, the affidavit of Milton K. Breslauer, sworn to October 5th, 1927, the summons and complaint herein, and upon Plaintiffs' Exhibits X, X1, X2, [fol. 86] X3, X4, Y and Z, and Defendant's Exhibits A and B, and the notice of motion dated September 29th, 1927, and after hearing Charles S. Rosenschein, Esq., of counsel for the plaintiffs in support of said motion for an injunction and in opposition to said motion to dismiss the complaint, and O. Ellery Edwards, Esq., as counsel for defendant, in opposition to said motion for injunction and in support of said motion to dismiss the complaint, and due deliberation having been had thereon, now upon filing the opinion of the Court, it is

Ordered that said motion for an injunction pendente lite be, and it hereby is granted; and it is further

Ordered that said motion to dismiss the complaint be, and it hereby is denied; and it is further

Ordered that the time of the defendant to answer the complaint herein be, and it hereby is extended to and including the 22nd day of October, 1927, and it is further

Ordered that the plaintiffs shall notice this case for trial for the November, 1927, Term at Special Term, Part III and be ready when said case is reached, and that the defendant may at his election serve an amended answer as of course at any time before the opening of the November, 1927, Term, without prejudice to the position of the case on the calendar or the necessity for a new notice of trial or a new note of issue and without costs; and it is further

Ordered that upon plaintiffs' filing in the office of the Clerk of Kings County an undertaking with sufficient sure[fol. 87] ties to the effect that the plaintiffs will pay to the defendant, such damages not exceeding the sum of $5,000 as defendant may sustain by reason of the injunction contained in this order, if the Court finally decides that the plaintiffs were not entitled thereto and that neither of the

plaintiffs was entitled thereto, the defendant and his agents and his servants be and they hereby are enjoined and restrained until the further order of this Court, from exercising any rights under the letters patent bearing No. 1634316 issued to the defendant by the United States Patent Office; from using, manufacturing, selling, hiring out or otherwise distributing or disposing of the instruments described in said letters patent or any similar instruments or any parts or modifications thereof; from transferring, assigning or granting any rights, licenses or privileges under said letters patent, or to such instruments or any similar instruments or parts or modifications thereof.

Enter:

Wm. B. Carswell, J. S. B.

Granted Oct. 21, 1927. Wm. E. Kelly, Clerk.

[fol. 88] EXHIBIT E TO ANSWER

Answer State Court Case 23237/27, Dated September 28, 1927

Defendant for his answer to plaintiffs' complaint herein alleges:

First. He denies the allegations in paragraphs designated 1, 4, 5, 6, 7, 8, 9, 11, 12, 16, 17 and 20 of plaintiffs' complaint contained.

Second. He denies any knowledge or information sufficient to form a belief as to the allegations in paragraphs designated 3, 14, 15 and 18 of plaintiffs' complaint contained.

Third. He admits the allegations in paragraph designated 19 of plaintiff's complaint contained except that he denies that part thereof which reads "to the irreparable injury of the plaintiff and said Oppenheimer."

For a Separate and Complete Defense

That this Court has not jurisdiction of the subject matter of the plaintiffs' complaint.

Wherefore defendant demands judgment dismissing plaintiffs' complaint and awarding defendant the costs and disbursements of this action.

Edwards & Henry, Attorneys for Defendant, 233 Broadway, New York City.

[fol. 89] State of New York,
County of New York, ss:

Edward Becher, being duly sworn, says that he is the defendant in the above entitled action; that he has read the foregoing answer and knows the contents thereof; that the same is true of his own knowledge except as to the matters therein stated to be alleged upon information and belief and that as to those matters he believes it to be true.

Edward Becher.

Sworn to before me this 28th day of September, 1927. Floyd M. Sheffield, Notary Public, Nassau County. N. Y. Co. Clerk 981, Register 9728. Queens Co. Clerk 2501, Register 4840. Commission expires March 30, 1929.

Exhibit F to Answer

Opinion Rendered by Mr. Justice Carswell on Reargument (Law Journal Nov. 15, 1927)

State Court Case No. 23237/27

Contoure Laboratories, Inc., and Ano.

v.

Becher

Motion for Reargument

The question of jurisdiction is to be determined from the complaint. New affidavits do not change that pleading, and therefore they present no new question upon the proposed reargument. The state court has jurisdiction to de-
[fol. 90] termine the question of whether or not Becher

breached any duty owing by him to the plaintiff, and if he did, whether or not the patent he obtained is the fruit of that breach and as such properly to be subjected by a decree of this court to the equitable rights arising therein in plaintiffs' favor by way of impressing them upon defendant's legal title to or in the patent issued in his name. The primary question is whether or not the defendant breached any duty owing to the plaintiff. If he did not, the state action fails; if he did, the next question is whether or not the Becher patent is the fruit of that breach. The question of originality may be, but not necessarily, involved. If this court determines that such a breach of duty occurred and that the Becher patent entirely belongs to the plaintiff in equity, the question of originality never arises. The remote possibility (not now apparent) that the facts may present an obstacle to the taking or exercising of jurisdiction does not require a holding that the complaint presents any such difficulty. Motion denied.

STATEMENT RE EXHIBIT G TO ANSWER

Amended and Supplemental Answer in State Court Action

Same as Exhibit 4, Rec., p. 24.

[fol. 91] EXHIBIT H TO ANSWER

Order of Judge Lewis in the State Court, Case No. 23237/27, Filed Dec. 19th, 1927

Upon the annexed stipulation, it is

Ordered that the issues in the above entitled action be and they hereby are referred to Hon. Russell Benedict, Official Referee, to hear and determine and that he make and file his report herein with all convenient speed.

Enter:

Harry E. Lewis, J. S. C.

EXHIBIT J TO ANSWER

Decision of Official Referee in the State Court Case No. 23237/27, Dated June 29, 1928

The issues in the above entitled action having been referred to me as Official Referee, to hear and determine by order made by Hon. Harry E. Lewis, one of the Justices of the Supreme Court of the State of New York, which order was dated December 19th, 1927, and was entered in the office of the Clerk of Kings County on December 19th, 1927, and said issues having been duly noticed for trial, and the isues having been tried on the 16th day of February, 1928, the 8th day of March, 1928, and the 7th day of June, [fol. 92] 1928, and after hearing all of the evidence adduced by the respective parties, I do find and decide as follows:

Findings of Fact

1. That at all times hereinafter mentioned, plaintiff Contoure Laboratories, Inc., was and now is a domestic corporation.

2. That in and prior to the month of December, 1925, the defendant was engaged in the business of general repairs of Links and Links knitting machines.

3. That prior to the year 1926, defendant had never made any massage machine or any drawing, sketch, model or sample of any massage machine or any part thereof.

4. That for a long time prior to December 18th, 1925, plaintiff Oppenheimer was engaged in inventing a massage machine.

5. That on the 18th day of December, 1925, plaintiff Oppenheimer filed in the office of the Commissioner of Patents at Washington, D. C., application for patent under Serial No. 76276 executed December 10th, 1925, copy of which was received in evidence as plaintiff's Exhibit 5.

6. That thereafter, in or about the month of December, 1925, plaintiff Oppenheimer engaged the defendant as a ma- [fol. 93] chinist to make certain mechanical parts of said machine, for which plaintiff Oppenheimer agreed to pay defendant.

7. That at the time of and prior to said engagement of the defendant by plaintiff, Oppenheimer, the latter informed the defendant that he had then pending an application for patent upon said massage machine.

8. That at the time of engaging the defendant as a machinist, said plaintiff Oppenheimer and the defendant agreed that the defendant as such machinist would from time to time do certain work for said plaintiff Oppenheimer, under the instructions and directions of said plaintiff Oppenheimer, both in duplication of the machine already made by plaintiff Oppenheimer, for which application for patent was already pending, and for improvements and modifications thereof in accordance with his said instructions and directions, for which said plaintiff agreed to pay defendant, and said parties further agreed that defendant would keep secret and confidential such information and knowledge as he would obtain from said plaintiff in the course of said instructions and directions by said plaintiff, and in the course of the services rendered and work done by the defendant as a machinist in that connection, and that defendant would not use the same for his own benefit or for the benefit of any one other than plaintiff Oppenheimer.

9. That thereafter and from time to time, said plaintiff Oppenheimer modified and improved the said machine and invention and engaged the defendant to make various mechanical parts of said machine and invention, as modified and improved.

10. That thereafter plaintiff Oppenheimer conceived a [fol. 94] modification and improvement to his said invention to the extent of placing the brass rods containing the heating elements inside the aluminum rollers instead of on top thereof, and inserting small separate end pieces in said rollers on which said brass rod should rest.

11. That thereafter and in or about the month of January, 1926, plaintiff Oppenheimer instructed and directed the defendant to change such of the duplicates of the machine so invented by him as defendant had manufactured, so that the position of the brass rod would be changed in accordance with the conception, modification and improvement of the plaintiff Oppenheimer aforesaid.

12. That thereafter and in or about the month of January, 1926, plaintiff Oppenheimer conceived and invented an improved massage machine hereinafter referred to and more particularly described.

13. That thereafter and in or about the months of January and February, 1926, plaintiff Oppenheimer further engaged defendant and defendant agreed to do certain work for said plaintiff under his instructions and directions, in the making of models to be used in application by plaintiff Oppenheimer for letters patent upon said improved massage machine, for which said plaintiff agreed to pay defendant, and defendant agreed to keep secret and confidential such information and knowedge as he would obtain [fol. 95] from said plaintiff in the course of such instructions and directions and in the course of the services rendered and work done by the defendant as a machinist, and not to use the same for his own benefit or for the benefit of any one other than plaintiff Oppenheimer.

14. That in or about the month of February, 1926, plaintiff Oppenheimer engaged an attorney to file application on his behalf for letters patent upon said improved massage machine, which said application was thereafter and on June 26th, 1926, filed in the office of the Commissioner of Patents at Washington, D. C., under Serial No. 118637, copy of which was received in evidence as plaintiff's Exhibit 21.

15. That at the time of originally engaging defendant to do said work and from time to time thereafter, plaintiff Oppenheimer relying upon the agreements aforesaid, necessarily disclosed to defendant his said inventions, massage machine and improved massage machine, and the modifications and improvements thereof, his ideas originating the same, the manner of making the same, the novelty thereof and of all its various parts, the use to which the same might be put, the commercial value thereof, the various methods of manufacturing the same and combining the elements of novelty thereof.

16. That in or about the month of February, 1926, said plaintiff Oppenheimer, relying upon the agreements aforesaid, necessarily disclosed to defendant in order to enable

him at the request of said plaintiff Oppenheimer to make models and to manufacture certain parts thereof, said im- [fol. 96] proved massage machine conceived by said Oppenheimer, which consisted of a heating element composed of asbestos and wire, enclosed in a brass tube, the whole thereof enclosed in an aluminum roller which rotated around the brass tube, itself stationary, and resting on two extra pieces of metal inserted in the ends of said roller, and connected or attached to a wooden handle with a metal frame or top bar over the roller, the heating element in the brass tube being connected with a wire running through the wooden handle intended to be connected with a source of electric energy, such as a socket.

17. That thereafter and under the instruction and direction of the plaintiff Oppenheimer, defendant made large quantities of said machines, all in accordance with the conception, ideas and invention of the plaintiff Oppenheimer.

18. That without the knowledge or consent of the plaintiffs or either of them and in or about the month of March, 1926, while he was thus engaged in making massage instruments and mechanical parts for said plaintiff Oppenheimer and after ascertaining from said plaintiff Oppenheimer the ideas, facts and information above set forth and all the facts concerning the said invention and machines of plaintiff Oppenheimer and the modifications and improvements thereof, defendant appropriated to his own use said ideas, said invention, machines and the modifications and improvements thereof, and in violation of his agreement aforesaid [fol. 97] and of the confidential relation between the parties, made application to the Commissioner of Patents of the United States in his own name for letters patent on said improved machine, by application known as Serial No. 97862.

19. That on or about the 27th day of March, 1926, defendant filed in the United States Patent Office a petition, specification, claims and oath under said application for letters patent bearing Serial No. 97862, which application was granted and letters patent issued to said defendant on or about July 5th, 1927, bearing No. 1,634,316.

20. That in said petition, specification, claims and oath the defendant falsely stated that he had invented said in-

strument; that he was the original, first and sole inventor thereof; that he did not know and did not believe that the same was ever known or used before his alleged invention or discovery thereof.

21. That said statements were false and untrue in that the defendant had misappropriated the knowledge obtained by him from plaintiff Oppenheimer during the course of his employment as machinist; that he had not invented said instrument; that he was neither the original nor the sole inventor thereof; that he knew and believed that the same was known and used before his alleged invention or discovery thereof, namely, by the said plaintiff Oppenheimer, who to the knowledge of the defendant was the inventor thereof, and that defendant knew that all of his said state- [fol. 98] ments were false and untrue.

22. That the letters patent thus applied for by the defendant and issued to him were for a machine consisting of a heating element composed of asbestos and wire, enclosed in a brass tube, the whole thereof enclosed in an aluminum roller which rotated around the brass tube, itself stationary, and resting on two extra pieces of metal inserted in the end of said roller, and connected or attached to a wooden handle with a metal frame or top bar over the roller, the heating element in the brass tube being connected with a wire running through the wooden handle intended to be connected with a source of electric energy such as a socket.

23. That until on or about the 15th day of August, 1927, neither the plaintiffs nor either of them had any knowledge either of said application by the defendant for said letters patent or of the issuance of said letters patent to the defendant.

24. That without such knowledge and until the discovery by the plaintiffs of the existence of said application for and issuance of said letters patent, they continued to procure the defendant to manufacture for them the machine invented by said plaintiff Oppenheimer.

25. That immediately upon discovering the existence of said application for and the issuance to the defendant of said letters patent, plaintiffs demanded that the defendant discontinue making any machines pursuant to the letters

[fol. 99] patent issued to the defendant, or similar thereto, or modifications or improvements thereof, and demanded that the defendant transfer, set over and assign to said plaintiff Oppenheimer all his right, title and interest in and to said letters patent issued in the name of the defendant, which the defendant refused to do.

26. That plaintiffs have invested large sums of money in the manufacture and distribution of said machines and have manufactured large quantities thereof.

27. That defendant threatens and intends to manufacture and sell instruments such as are described in said letters patent issued to him, to the irreparable injury of the plaintiffs, and has such instruments and parts thereof in his possession.

28. That the plaintiffs have no adequate remedy at law.

29. That from June, 1926, and continuously thereafter, plaintiff Contoure Laboratories, Inc., was engaged in marketing said massage machines so conceived and invented by plaintiff Oppenheimer.

30. That until the month of August, 1927, the massage machines thus marketed by plaintiff Contoure Laboratories, Inc., were manufactured at the request of the plaintiffs by defendant Becher.

31. That plaintiff Contoure Laboratories, Inc., has filed a consent that the assignment to be made by the defendant [fol. 100] of the patent issued in the name of the defendant on July 5th, 1927, be to plaintiff Oppenheimer alone, and that all instruments and parts thereof in the possession of the defendant be delivered to plaintiff Oppenheimer alone and that in said consent, plaintiff Contoure Laboratories, Inc., waived any direction that said assignment be made and said instrument and parts thereof be delivered either to itself and plaintiff Oppenheimer jointly.

32. That this is a difficult and extraordinary case within the provisions of Section 1513 of the Civil Practice Act wherein a defense was interposed.

33. That the value of the subject matter involved in this action is equal to at least the sum of $20,000.

Conclusions of Law

1. That the defendant is and ever since March, 1926, has been a trustee ex maleficio for the benefit of plaintiff Oppenheimer of said invention and the letters patent issued to the defendant under No. 1,634,316 and any and all modifications and improvements thereof.

2. That plaintiffs are entitled to judgment:

(a) Declaring the defendant now and ever since March, 1926, a trustee ex maleficio for the benefit of plaintiff Oppenheimer of said invention and the letters patent issued to defendant under No. 1,634,316 and any and all modifications and improvements thereof;

[fol. 101] (b) Directing the defendant within 5 days after service of notice of entry of judgment upon the attorneys for the defendant, to deliver to the plaintiffs at the office of Moers & Rosenschein, attorneys for the plaintiff, 280 Madison Avenue, in the Borough of Manhattan, City of New York, an assignment of patent in the form of the proposed assignment hereto annexed and marked Exhibit A, duly executed and acknowledged by defendant;

(c) Forever enjoining and restraining the defendant from using, manufacturing, selling, hiring out or otherwise using, distributing or disposing of any of said instruments or any parts thereof or modification or improvement thereof;

(d) Forever enjoining and restraining the defendant from transferring, assigning or granting any rights, licenses or privileges under said letters patent or to such an instrument or any similar instruments or parts or modifications or improvements thereof;

(e) Directing the defendant to deliver up to plaintiff Oppenheimer all instruments and parts thereof now in his possession;

(f) Granting to plaintiffs an extra allowance in the sum of $1,000;

(g) Granting to plaintiffs the costs and disbursements of this action, together with such extra allowance, and an execution therefor;

(h) Providing that plaintiff have such other and further [fol. 102] relief as this Court may direct after the entry of judgment at the foot of said judgment.

I direct that judgment be entered accordingly.
Dated New York, June 29, 1928.
Russell Benedict, Official Referee of the Second Judicial Dept.

Exhibit A, see below.

STATEMENT RE EXHIBIT A TO EXHIBIT "J"

Exhibit A attached to Exhibit J same as Exhibit 7. See p. 31.

Exhibit A attached to Exhibit K is not reprinted as it is the same as that attached to Exhibit J. See Rec., p. 31.

STATEMENT RE EXHIBIT K TO ANSWER

Judgment in State Court Action.
Exhibit K same as Exhibit 7. See p. —.

[fol. 103] IN UNITED STATES DISTRICT COURT

ORDER DENYING APPLICATION FOR INJUNCTION, ETC., JULY 11, 1928—Filed July 12, 1928

An application made by the plaintiff for an injunction having duly come on to be heard on the 10th day of July, 1928, now, after reading the order to show cause signed by United States District Judge William Bondy, the affidavit of Edward Becher, sworn to July 6th, 1928, and the exhibits thereto annexed, the affidavit of Herbert Oppenheimer, sworn to July 10th, 1928, and the exhibits thereto annexed, the bill of complaint and the answer thereto, and after hearing O. Ellery Edwards, Esq., counsel for the plaintiff in support of said application, and Moers & Rosenschein, attorneys for the defendants, Chas. S. Rosenschein, Esq., of counsel, in opposition thereto, and due deliberation having been had thereon, it is

Ordered that said application be and it hereby is in all respects denied; and it is further

Ordered that the restraining order contained in the order to show cause of United States District Judge William Bondy dated July 10th, 1928, be and it hereby is in all respects vacated and set aside and declared null and void henceforth.

Julian W. Mack, United States Circuit Court.

[fol. 104] In United States District Court

[Title omitted]

Petition for Appeal and Assignment of Errors

To the Honorable, the District Judges of the United States in and for the Southern District of New York:

The above named plaintiff, Edward Becher, conceiving himself to be aggrieved by the interlocutory decree made herein on the 11th day of July, 1928, wherein a motion for a preliminary injunction was denied as to claims 1 and 4 of the Letters Patent in suit No. 1,634,316 granted to the plaintiff, Edward Becher, the 5th day of July, 1927, and also a motion for an injunction restraining the defendants from further proceedings in the Supreme Court of the State of New York for Kings County in a case pending between the parties No. 23237/27, does hereby appeal to the United States Circuit Court of Appeals in and for the Second Circuit from said decree for the reasons set forth in the assignment of errors, forming a part hereof, and it prays that this, its petition for appeal, may be allowed and that a transcript of the record, proceedings and papers upon [fol. 105] which said decree was entered, may be transmitted with this appeal to the said Circuit Court of Appeals. And the plaintiff presents with the above petition for appeal the following assignments of errors:

1. The District Court erred in refusing the preliminary injunction as prayed for in paragraphs 2 and 4 of the Bill of Complaint herein and as to claims 1 and 4 of the patent in suit.

2. The District Court erred in not holding said patent in suit No. 1,634,316 valid and infringed as to claims 1 and 4.

3. The District Court erred in holding that it had no jurisdiction to restrain further proceedings in the case

between the same parties pending in the Supreme Court of the State of New York for Kings County No. 23237/27.

O. Ellery Edwards, Solicitor for Plaintiff.

[fol. 106] In United States District Court

Order Allowing Appeal

The foregoing petition for appeal is allowed and the claim of appeal therein made is allowed.

It is further ordered that Edward Becher file a bond herein in favor of the defendants and approved by this Court in the sum of $250.00 conditioned upon the payment of all costs and damages that may be awarded by this Court against this plaintiff if this plaintiff fails to make this appeal good.

Dated, July 11th, 1928.

Julian W. Mack.

Usual appeal bond in favor of the defendants in the sum of $250 filed July 12, 1928.

[fol. 107] Citation, in usual form, omitted in printing.

[fol. 108] In United States District Court

[Title omitted]

Stipulation re Transcript of Record

The Court consenting, it is stipulated and agreed by and between counsel that the record on appeal in this case shall consist of the papers named below, titles being abbreviated so as to avoid unnecessary repetition and each paper fully identified with a title and filing date, as set forth below.

It is agreed that where papers are duplicated, one printing shall be sufficient with a cross reference showing where the text is found in the record.

1. The bill of complaint filed July 6, 1928.

2. Order to show cause signed by Judge Bondy filed July 6, 1928 at 3:47 P. M.

3. Affidavit of Edward Becher filed July 6, 1928 and exhibits thereto attached as follows:

Exhibit 1, copy of Becher patent in suit No. 1,634,316.

Exhibit 2, physical exhibit which will not form part of the [fol. 109] record, but may be used by either party at the hearing.

Exhibit 3, copy of complaint in the State Court case pending between the same parties in the Supreme Court of the State of New York for Kings County No. 23237/27.

Exhibit 4, amended and supplemental answer in said State Court case.

Exhibit 5, a copy of the drawing of the Oppenheimer application filed in June, 1926.

Exhibit 6, a copy of the declaration of interference between the parties declared in October, 1927.

Exhibit 7, order against Becher entered in the State Court case July 5, 1928.

4. Memorandum by Judge Mack filed July 10, 1928.

5. Affidavit of Herbert Oppenheimer filed July 11, 1928 and exhibits annexed thereto as follows:

Exhibit 1, copy of the Oppenheimer application filed in December, 1925.

Exhibit 2, copy of the Oppenheimer application filed in June, 1926. Exhibits 3, 4 and 5, Drawings. (The copy of the drawing of this application is attached to the Becher affidavit as Exhibit 5.)

6. Answer of the defendants filed July 11, 1928 and attached exhibits as follows:

Exhibit A, copy of the summons in the State Court case between the parties, of which Exhibit 3 attached to the Becher affidavit is the complaint.

[fol. 110] Exhibit B, the said complaint in the State Court.

Exhibit C, the opinion of Mr. Justice Carswell in said State Court case.

Exhibit D, the order of Mr. Justice Carswell in the said State Court case.

Exhibit E, the answer in said State Court case.

Exhibit F, the second opinion of Mr. Justice Carswell in the said State Court case.

Exhibit G, the amended and supplemental answer in said State Court case.

Exhibit H, the order of reference in said State Court case.

Exhibit J, the decision in said State Court case signed by the referee, Russell Benedict, Esq.

Exhibit A annexed to Exhibit J, the proposed assignment of Becher to Oppenheimer of the patent in suit.

Exhibit K, the final decree in said State Court case.

Exhibit A annexed to Exhibit K, another copy of the proposed assignment of Becher to Oppenheimer of the patent in suit.

7. The order of Judge Mack dated the 11th day of July, 1928 and filed July 12, 1928.

8. Petition for appeal, assignment of errors and order allowing appeal dated July 11, 1928 and filed July 12, 1928.

9. It is admitted that an appeal bond in favor of the defendants in the sum of $250 has been filed the 12th day [fol. 111] of July, 1928 in the District Court in this case by the party Becher and that the printing thereof is unnecessary.

10. Citation.

11. This stipulation.

12. The usual Clerk's certificate.

O. Ellery Edwards, Solicitor for Plaintiff. Moers & Rosenschein, Solicitors for Defendants.

Dated New York, July 16, 1928.

So ordered. Julian W. Mack, U. S. C. J.

[fol. 112] In United States District Court

[Title omitted]

Stipulation re Transcript of Record

It is hereby stipulated and agreed, that the foregoing is a true transcript of the record of the said District Court in the above-entitled matter as agreed on by the parties.

Dated —— —, 1928.

O. Ellery Edwards, Attorney for Appellant. Moers & Rosenschein, Attorney for Appellees.

[fol. 113] Clerk's certificate to foregoing transcript omitted in printing.

UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SECOND CIRCUIT

EDWARD BECHER, Plaintiff-Appellant,

vs.

CONTOURE LABORATORIES, INC., and HERBERT OPPENHEIMER, Defendants-Appellees

Before Manton, L. Hand, and Swan, JJ.

Appeal from the District Court of the United States for the Southern District of New York

In a suit in equity for infringement of Letters Patent No. 1,634,316, plaintiff's motion for an interlocutory injunction was denied. Order affirmed and cause remanded with directions to dismiss the bill of complaint.

O. Ellery Edwards, Solicitor for Appellant.

Moers & Rosenschein, Solicitors for Appellees, Charles S. Rosenchein, of Counsel.

SWAN, Circuit Judge:

The relief sought on the motion for a preliminary injunction was two fold: (1) to prevent infringement of Becher's Patent, and (2) to prevent the further prosecution by defendants of a suit pending between the same parties in the Supreme Court of the State of New York, wherein judgment had been entered directing Becher to assign his said patent to Herbert Oppenheimer, one of the plaintiffs in that litigation and a defendant in this. But the whole argument centers upon the refusal of the District Court to enjoin prosecution of the State suit; if the State court had jurisdiction, its judgment precludes plaintiff from claiming infringement by the defendants. The appellant contends that that court had no jurisdiction of the litigation because it was a case arising under the patent laws of the United States and so within the exclusive jurisdiction of Federal tribunals. Sec. 256 of the Judicial Code (U. S. C. A., Tit. 28 Sec. 371).

In the State suit, Oppenheimer and his assignee Contoure Laboratories were plaintiffs. They allege that Op-

penheimer was the proprietor of an invention for a certain massaging instrument, and was engaged in devising improvements thereof; that he employed Becher to make mechanical parts of said instrument and Becher agreed to keep secret and confidential such information as he should obtain from Oppenheimer in the course of doing such work; that Oppenheimer disclosed to Becher his said invention and modifications and improvements thereof in order that Becher might perform the agreed work, and that Becher appropriated Oppenheimer's ideas and invention and in violation of his aforesaid agreement made application for a patent upon said instrument and obtained upon said application the issuance of Letters Patent No. 1,634,316; that in said application Becher falsely stated that he was the inventor although in fact, as Becher knew, Oppenheimer was the inventor of said instrument; that Oppenheimer had assigned his interest in said invention and instrument to Contoure Laboratories; that upon learning of the patent issued to Becher, Oppenheimer and his assignee demanded that Becher discontinue making instruments pursuant to said Letters Patent, and assign the Patent to them; that they have established a substantial trade in such instruments and that Becher's sale of instruments such as are described in said Letters Patent causes them irreparable injury. The prayer for relief is (1) that Becher be declared a trustee ex maleficio for Oppenheimer's assignee of said invention and the Letters Patent; (2) that he be restrained from using or disposing of said instruments; (3) that he be enjoined from granting any rights under said Letters Patent; (4) that he deliver up to the plaintiffs all instruments in his possession; and (5) for damages and other appropriate relief. Becher's answer denied the allegations of the complaint; alleged the issuance to himself on July 5, 1927, of said Letters Patent, that subsequently thereto Oppenheimer had amended a patent application which he had filed on June 26, 1926, and an interference had been declared between Becher's Letters Patent and Oppenheimer's amended application which interference remained pending and undetermined in the Patent Office; and denied the jurisdiction of the State court. The State court sustained its own jurisdiction and trial was had before a referee, who made a finding of facts supporting all of the

allegations of the bill. Judgment was thereupon entered adjudging Becher a trustee ex maleficio for the benefit of Oppenheimer of the invention and Letters Patent and directing him to execute an assignment of the Patent. Injunctive relief was also granted in accordance with the prayer of the bill. Becher then filed the present suit to obtain an adjudication of the validity of his patent and to enjoin the enforcement of the State court judgment.

The exclusive jurisdiction of Federal courts in cases arising under the patent laws does not preclude State courts from exercising their customary common law and equity jurisdiction merely because a patent is involved in the litigation. It is well settled that a State court may try questions of title and may construe, enforce or annul contracts relating to patents. Marsh v. Nichols, 140 U. S. 344; New Marshall Engine Co. v. Marshall Engine Co., 223 U. S. 473; Luckett v. Delpark, 270 U. S. 496; Binney v. Annan, 107 Mass. 94; see also Wittemann Bros. v. Wittemann Co., 88 N. Y. Misc. 266; Hanson v. Hall Mfg. Co., 190 N. W. 967 (Iowa). This applies as well when a contract to assign is implied from the relationship of the parties as when it is express. Air Reduction Co. v. Walker, 118 N. Y. Misc. 827; Annin v. Wren, 44 Hun. 352, 353; Fuller & Johnson Mfg. Co. v. Bartlett, 68 Wis. 73. In such cases, of course, the plaintiff asserts nothing which questions the validity of the defendant's patent.

In the case at bar, the plaintiff in the State suit charged that the defendant got from him the ideas which were embodied in the patent. This fact, if true, would mean that the patent issued to defendant was null and void. Kennedy v. Hazelton, 128 U. S. 667. Merely to get an idea from another is not a tort—the inventor may have freely communicated it. In that event the inventor has no recourse except to an interference in the Patent Office, if the borrower files an application for a patent embodying his idea. But the idea may have been obtained under circumstances which forbid the borrower to make use of it for his own benefit. The complaint in the State suit alleged and the court found, that Becher had agreed to keep secret and confidential such information as Oppenheimer gave him concerning his massaging instrument; and that in violation of this agreement and of the confidential relationship between

the parties, Becher embodied this information in his application for a patent. If the invention had been merely a trade secret, Oppenheimer could have enjoined Becher from using it for his own benefit and could have compelled him to account for anything of value which he had obtained by wrongful use of it. Morison v. Moat, 9 Hare 241; Du Pont Powder Co. v. Masland, 24; U. S. 100. This should be equally true when the secret is an invention.

The only question is whether the undoubted jurisdiction of the State court to compel a wrongdoer to account is divested because the incidental result will be to establish a fact between the parties which affects the validity of a patent. The exclusive jurisdiction of the Federal courts in patent cases does not, we think, go so far. In Pratt v. Paris Gas Light & Coke Co., 168 U. S. 255, 259, Mr. Justice Brown says:

"The action under consideration is not one arising under the patent right laws of the United States in any proper sense of the term. To constitute such a cause the plaintiff must set up some right, title or interest under the patent laws, or at least make it appear that some right or privilege will be defeated by one construction, or sustained by the opposite construction of these laws. * * *

"* * * There is a clear distinction between a case and a question arising under the patent laws. The former arises when the plaintiff in his opening pleading—be it bill, complaint or declaration—sets up a right under the patent laws as ground for a recovery. Of such the state courts have no jurisdiction. The latter may appear in the plea or answer or in the testimony. The determination of such question is not beyond the competency of the state tribunals."

That case held that a State court is not ousted of jurisdiction by the fact that incidentally to his defense the defendant claims the invalidity of a certain patent. True, there the defendant set up the patent's invalidity, while here it appears on the face of the complaint, as it did in Middlebrook v. Broadbent, 47 N. Y. 443. But it appears only incidentally and as an element of plaintiff's proof. Oppenheimer's complaint sets up no "right under the patent laws as ground for a recovery," to repeat Justice Brown's phrase His cause of action is based on equitable principles appli-

cable to any wrongful use of confidential information which the defendant had agreed to keep secret. It is true that a question of fact was decided which determines the invalidity of Becher's patent as between the parties and estops him upon that issue whenever it arises again between him and Oppenheimer. But if the jurisdiction of State courts were limited by such incidental consequences, they would be unable to adjudicate all sorts of cases. For example, an action of replevin might involve the question whether the plaintiff had made a machine in defendant's possession. That machine might be a prior use of an invention which defendant had patented. Surely it cannot be that the State court would have no jurisdiction of the replevin suit because the judgment therein would establish that the machine was of plaintiff's construction and so anticipated the patent. Yet the appellant must go so far to succeed in the case at bar.

The appellant has cited no authority which clearly sustains his position and none has been found by independent research. In Cheatham Elec. &c. Co. v. Kentucky S. & S. Co., 213 Ky. 231, 280 S. W. 469, chiefly relied upon, plaintiff sought a declaratory judgment that certain patents owned by it gave it the right, denied by defend, to make and sell certain articles. The petition was rightly dismissed for lack of jurisdiction because plaintiff was asserting rights under the patent laws. The defendant filed a counter claim, which was somewhat comparable to Oppenheimer's suit, and this was dismissed because it necessarily followed the disposition of the original petition. In Standard Scale &c. Co. v. McDonald, 127 F. 709 (C. C. Mo.) also relied upon, the bill alleged that Orcutt invented a wagon scale while employed by defendants, that he applied for a patent upon said invention and later learned that the defendants had previously applied and obtained a patent for said invention, that they were not the original inventors and obtained their patent by fraudulent representations to the Patent Office and in fraud of the rights of the first inventor, Orcutt, who had assigned his invention to the plaintiff. The relief sought was an injunction to restrain defendants from manufacturing under their patent, and an accounting. A demurrer was sustained to this bill upon the ground that the issue of originality of invention was for determination in

the interference in the Patent Office. This case differs from the case at bar in that there is no allegation that the defendants had contracted with Orcutt to keep secret his invention or that the relations of the parties were such that defendants committed a tort upon Orcutt in disclosing it to the Patent Office. It is true that the defendant are alleged to have obtained their patent by a fraud upon the Patent Office and "in fraud of the rights of" Orcutt, but his rights thus referred to were apparently merely the inchoate right which every inventor has to apply for and secure a patent. It was not a right sustained by acknowledged common law or equitable principles and no conduct of the defendants was charged which amounted to a breach of contract or a tort. Judge Philips in deciding the McDonald case relied upon Hoeltge v. Hoeller, Fed. Cas. 6574, which is similarly distinguishable from the case at bar.

On the other hand, in Murjahn v. Hall, 119 F. 186 (S. D. N. Y.), where the allegations are similar but contain the additional statement that the defendant induced the plaintiff to disclose his invention by representing that the information would be kept secret, the bill of complaint was sustained against demurrer. Judge Townsend's opinion says (p. 188):

"Upon the facts submitted on demurrer in the case at bar, complainant had made an invention which he might legally keep secret, and thus secure the benefits to himself. Defendant obtained its disclosure by the representation that such disclosure would not deprive the complainant of the benefit of the invention, and that defendant would not disclose it to others, and would be a large purchaser of the paint; and, having learned it, he proceeded to use it to complainant's disadvantage and make large profits thereby. Upon those facts complainant should be entitled to an accounting and an injunction."

The basis of Federal jurisdiction does not appear in the opinion. If it was diversity of citizenship, this decision would be an authority in favor of the jurisdiction of a State court. In commenting upon this case in the McDonald case, Judge Phillips remarked:

"The opinion of Judge Townsend, in the latter case, is quite brief. The conclusion of the court would seem to

have been influenced by the consideration that the defendant had, by cunning and deceit, obtained the complainant's secret of invention, and that it inheres in the principles of equity jurisprudence to obstruct and prevent the enjoyment of the fruits of such fraud. It did not appear in that case, as in the one at bar, that the complainant had filed his application for a patent with the Commissioner of Patents, and that such application was pending before the Commissioner at the time of the issuance of the patent to the defendant."

In the case at bar, the bill of complaint does not allege that Oppenheimer had filed an application in the Patent Office, although that fact is brought in by Becher's answer. It is not in our judgment material. Oppenheimer is not asserting any right by reason of an application for a patent nor any right under the patent laws. He is relying solely upon common law and equitable principles to prevent a wrongdoer from profiting by the disclosure of information obtained under circumstances which bound him to keep it secret and to account for such profit as he has made by wrongful use of the information. It may be that the relief prayed and granted goes too far. Becher has been ordered to assign a void patent. From Kennedy v. Hazelton, 128 U. S. 667, it appears that this should not have been ordered because, as the court there points out, the only value which a void patent could have to the assignee would be to enable him to impose upon the public. But this goes merely to an error of law committed by the State court in its judgment, not to a lack of jurisdiction to render any judgment. On the court's finding that Becher had obtained knowledge of the invention under circumstances which bound him to keep it secret, Oppenheimer was entitled to an injunction against improper use by Becher of such knowledge. Authority, as well as principle, sustains the State court's jurisdiction to grant such relief. Smith & Egge Mfg. Co. v. Webster, 87 Conn. 74; Irving Iron Works v. Kerlow Steel Flooring Co., 126 Atl. 291 (N. J.). As to copyright, see Underhill v. Schenck, 238 N. Y. 7, 14; Hoyt v. Bates, 81 F. 641 (C. C. Mass.).

Appellant's attorney upon the argument invited us to dismiss the bill if we concluded that the State court had jurisdiction. On the authority of Mast, Foos & Co. v.

Stover Mfg. Co., 177 U. S. 485, we have power to do so. Accordingly the decree is affirmed and the cause remanded with directions to dismiss the bill of complaint.

[Endorsed:] United States Circuit Court of Appeals, Second Circuit. Edward Becher, Plaintiff-Appellant, vs. Contoure Laboratories, Inc., and Herbert Oppenheimer, Defendant-Appellees. Opinion. Swan, C. J.

UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SECOND CIRCUIT

EDWARD BECHER, Plaintiff-Appellant,

against

CONTOURE LABORATORIES, INC., and HERBERT OPPENHEIMER, Defendants-Appellees

MANTON, Circuit Judge (dissenting):

Patent No. 1,634,316 was granted to appellant on July 5, 1927, on an application filed March 27, 1926, for a massage heating roller. The present suit is for infringement of this patent and for an injunction restraining the further prosecution of an equity suit in the New York State Court between the parties. Appellant, prior to the filing of his application for this patent, made the device for the appellee Oppenheimer. Appellant alleges it was unsuccessful and although modified, did not succeed and has been abandoned. After appellant filed his application for this patent, he furnished apparatus for the same to the appellee. Oppenheimer filed a later application for a patent, June, 1926. In August, 1927, the parties disagreed. Appellee, Contoure Laboratories, Inc., incorporated by Oppenheimer, took over the latter's business. Oppenheimer filed an amendment to his application of June 26, 1927, and claimed appellant's patent and asked for an interference between the parties. But before that interference was declared, appellee brought suit against the appellant in the Supreme Court of the State of New York. The complaint alleged that Oppenheimer disclosed the idea of the Becher patent to him and that Becher fraudulently took out a patent in defiance of Op-

penheimer's rights. The interference has never been prosecuted and is still pending. The present suit for infringement brings into question who is the first inventor, the claim being that the Federal Court only has exclusive jurisdiction of this issue. It is contended that the state court erroneously took jurisdiction and decided this question which is one arising under the patent laws of the United States. Sec. 256 U. S. Judicial Code.

The complaint in the state court did not claim an expressed contract whereby appellant was to apply his inventive skill to the use of the appellee nor is it claimed that a contract exists by which the resulting invention of the appellant, made during such employment, must pass to the appellee. But the complaint in the state court stated:

"that defendant (present plaintiff) appropriated to his own use said ideas and said invention and the modification and improvements thereof, an in violation of his agreement (to keep Oppenheimer's ideas secret) made application to the Commissioner of Patents of the United States for letters patent."

It alleged a fraudulent use of Oppenheimer's ideas. The complaint did not allege that the plaintiff had agreed to assign his invention, but, on the contrary, says that he did not invent anything and if the appellees' theory is right, then the patent is void. Kennedy v. Hazelton, 128 U. S. 667. The issue in the state court was whether the patent obtained by plaintiff was a product of his own genius, while in the employ of the appellee, or whether it was a fraudulent use of Oppenheimer's idea. The solution of this question necessarily required a challenge to the validity of the patent obtained by the appellant. The issue was not whether a patent, concededly valid, is the product of appellant's genius and as such, should be assigned under an implied contract of assignment. The suit sounded in tort and not in assumpsit.

It may not be doubted now that the state courts are permitted to adjudicate suits which may incidentally involve the patent law, as in Luckett v. Delpark, 270 U. S. 496, in which case it was pointed out that the complainant did not, by its bill in the state court, raise any question as to the validity or construction of the patent nor did it make any

claim for damages for infringement. That suit was an ordinary bill for specific performance to complete the assignment to complainant for an improvement of a patent in compliance with his covenant for further assurance, and it was held that the defendant there held the legal title as trustee for the complainant and that the state court had jurisdiction to pass upon the ownership. That case did not arise under the patent law. The main and declared purpose was to enforce the rights of the plaintiff under contract with the defendants for royalties and the reconveyance of one patent. The issues there were whether the assignee of a patent was performing his contractual duties, the patent being concededly the assignor's while in the case at bar the issue was whether the appellant made his own discovery or fraudulently used Oppenheimer's. At bar there is no contract of assignment whatever upon which a state court could permissibly adjudicate the question of who is the first inventor, and a mere reading of the decision and findings in the state court point out clearly that the basis of decision was a determination by the trial judge that Oppenheimer's was the first conception and that appellant took his ideas in applying for the patent. It is not intimated that the appellant was to apply for the patent in Oppenheimer's behalf. Appellant's claim was that the idea of the patent was his own knowledge. The state trial court in decision merely held that Oppenheimer made certain discoveries and not the appellant and therefore they were not of the appellant's discovery. It is the same issue that is presented in the interference proceeding. Congress long ago determined to leave that to the Patent Office. New Marshall Engine Co. v. Marshall Engine Co., 223 U. S. 473; Excelsior Wooden Pipe Co. v. Pacific Bridge Co., 185 U. S. 282; St. Paul Plough Works v. Starling, 127 U. S. 376. In Pratt v. Paris Gas Light & Coke Co., 168 U. S. 255, the plaintiff sued in the state court to recover a sum of money for the manufacture and installation of a water gas device. The defendant pleaded that the plaintiff had guaranteed to save him harmless and defend him in any suit brought by third parties for patent infringement; that the patent laws under which the plaintiff made the apparatus were void and an infringement of the patent of another company which had sued the defendant for infringement; that the plaintiff

had not defended the suit and that the defendant had thus been compelled to cease using the apparatus. At the trial, the defendant introduced evidence tending to show defendant's patent infringed that of the other company, in support of the allegations of its defense, the Supreme Court said:

"The action, however, was not brought to test the validity of the plaintiff's patents; to recover damages for the infringement, or to enjoin the use by the defendant. The suit was an ordinary action of assumpsit upon the common counts for the price of a machine—a patented machine it is true—but none the less subject to a common law action to recover its value."

The question of the validity of the patent was raised collaterally in the state court, but at bar it is in direct litigation between the alleged patentee and the infringer and the issue of validity of the patent was squarely raised by the appellee in the state court when he took the position that the appellant was not the discoverer of the device for which he had obtained a patent. Therefore cases like Wade v. Lawder, 165 U. S. 624; Dale Tile Mfg. Co. v. Hyatt, 125 U. S. 46; By Products Recovery Co. v. Mabee, 288 Fed. 401; Underhill v. Schenck, 238 N. Y. 7 and Wittemann Bros. v. Wittemann Co., 88 Misc. Rep. 266, which hold merely that the state court has jurisdiction to determine the question of whether a contract for assignment of a defendant's interest in a pending or existing patent has been breached, are not in point. In Craig &c. Corp. v. Static Control Co., 295 Fed. 72, this Court had before it a claim of a plaintiff who alleged an assignment of the defendant's patent to him whereby he became the sole owner of the invention and any improvements thereon. The bill alleged that the defendants thereafter established defendant corporation and manufactured articles infringing the plaintiff's patent. The defendant said the articles were manufactured under the separate patent issued to him. The plaintiff at the trial sought to prove that an officer of the plaintiff was the inventor of the second patent and not the defendant. This court held that the defendant's device did not infringe but upon the claim that the plaintiff's officer was the inventor

and not the defendant, this court after a review of the provisions of the statute, said:

"It is thus apparent that any priority controversy except one arising under §§4915 and 4918 (which is not material in the instant case) of the Revised Statutes is to be considered a finality in any subsequent infringement litigation where the patent in suit is not a patent granted on the invention which was involved in said priority controversy in the Patent Office. Until the applicant has exhausted his rights through the tribunals of the Patent Office, he may not raise the questions here sought to be raised in the district court."

This would have the same application in the State Court. Affirming the district court, we said:

"The exclusive remedy of the appellant for testing the priority of invention is with that tribunal (patent office) except in a direct suit by the Smith patentee for infringement, where the validity of his patent including questions of originality and date of invention might be litigated."

And further as to the third cause of action, it was alleged that it was based upon a contract of assignment, and we held it did not raise a question as to "patentability, title, scope, or monopoly of any patent" and that it was a matter for the state court to decide since there was no diversity of citizenship.

The application of the authorit ive holdings to the facts of the present suit, support the maintenance of this suit in the district court and we should hold that the state court was without jurisdiction because the suit there was based upon the application of the patent laws of the United States. Cheatham Electric Switching Device Co. v. Ky. Switch & Signal Co., 213 Ky. 23.

A preliminary injunction should be granted. This Court has held that where there is no proof of long continued acquiescence by the public as would raise a prima facie case in the patentee's favor, it is the practice to refuse a preliminary injunction. Simpson Bros. Inc. v. Blancard & Co., Inc., 22 Fed. (2d) 498; Hildreth v. Norton, 150 Fed. 428. However, it does appear that by reason of an improper as-

sumption of jurisdiction in the state court, the appellant, who has the presumption of validity of the patent in his favor, is being deprived of the rights thus accorded him by reason of the result in the state court. Infringement by the defendant continues and moreover assumption of the title, by reason of the state court decision, places appellees in control of the manufacturing of the device. Appellant should have equitable relief under these circumstances and an injunction should be granted against further infringement until a trial may be had of the issue presented as to who was the first inventor. An injunction restraining proceedings on the state court decree may be granted under the general equity powers of the district court. Simon v. So. Ry. Co., 236 U. S. 115.

For the reasons stated, I dissent.

[Endorsed:] United States Circuit Court of Appeals, Second Circuit. Edward Becher vs. Contoure Laboratories, Inc., & Ano. (Copy.) Dissenting opinion, Manton, Circuit Judge.

United States Circuit Court of Appeals, Second Circuit

At a stated term of the United States Circuit Court of Appeals in and for the Second Circuit, held at the court-rooms, in the Post Office building, in the city of New York, on the 19th day of November, one thousand nine hundred and twenty eighth.

Present: Hon. Martin T. Manton, Hon. Learned Hand, Hon. Thomas W. Swan, Circuit Judges.

Edward Becher, Plaintiff-Appellant,

v.

Contoure Laboratories, Inc., and Herbert Oppenheimer, Defendants-Appellees

Appeal from the District Court of the United States for the Southern District of New York

This cause came on to be heard on the transcript of record from the District Court of the United States for the

Southern District of New York and was argued by counsel.

On consideration whereof, it is now hereby ordered, adjudged, and decreed that the decree of said District Court be, and it hereby is, affirmed, with costs, and cause remanded with directions to dismiss the bill of complaint.

It is further ordered that a Mandate issue to the said District Court in accordance with this decree.

L. H., T. W. S.

[Endorsed:] United States Circuit Court of Appeals, Second Circuit. Edward Becher v. Contoure Laboratories, Inc. Order for mandate. United States Circuit Court of Appeals, Second Circuit. Filed Nov. 19, 1928. William Parkin, Clerk.

UNITED STATES CIRCUIT COURT OF APPEALS, SOUTHERN DISTRICT OF NEW YORK

I, William Parkin, Clerk of the United States Circuit Court of Appeals for the Second Circuit, do hereby certify that the foregoing pages, numbered from 1 to 132, inclusive, contain a true and complete transcript of the record and proceedings had in said court in the case of Edward Becher, plaintiff-appellant, against Contoure Laboratories, Inc., and Herbert Oppenheimer, defendants-appellees, as the same remain of record and on file in my office.

In testimony whereof I have caused the seal of the said court to be hereunto affixed, at the City of New York, in the Southern District of New York, in the Second Circuit, this 20th day of November, in the year of our Lord one thousand nine hundred and twenty-eight, and of the Independence of the said United States the one hundred and fifty-third.

Wm. Parkin, Clerk.

[fol. 134] SUPREME COURT OF THE UNITED STATES

ORDER ALLOWING CERTIORARI—Filed January 7, 1929

The petition herein for a writ of certiorari to the United States Circuit Court of Appeals for the Second Circuit is granted. And it is further ordered that the duly certified copy of the transcript of the proceedings below which accompanied the petition shall be treated as though filed in response to such writ.

Endorsed on cover: File No. 33,868. U. S. Circuit Court of Appeals, Second Circuit. Term No. 559. Edward Becher, petitioner, vs. Centoure Laboratories, Inc., and Herbert Oppenheimer. Petition for writ of certiorari and exhibit thereto. Filed November 27th, 1928. File No. 33,868.

(5763)